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# The Medium is the Message: Copyright Law Confronts the Information Age in *New York Times v. Tasini*

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THE MEDIUM IS THE MESSAGE<sup>1</sup>: COPYRIGHT  
LAW CONFRONTS THE INFORMATION AGE IN  
*NEW YORK TIMES V. TASINI*<sup>2</sup>

I. INTRODUCTION

Marshall McLuhan theorized that the medium is the message; that society is shaped by the way in which we communicate rather than by what we are communicating.<sup>3</sup> The Internet,<sup>4</sup> the emerging online

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1. See MARSHALL MCLUHAN & QUENTIN FIORE, *THE MEDIUM IS THE MESSAGE* (Jerome Agel Coordinator, Bantam Books 1967). See *infra* note 3.

2. *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (allowing publishers to place freelance articles in electronic databases under the revision privilege in §201(c) of the Copyright Act), *rev'd*, 206 F.3d 161 (2d Cir. 1999); *Tasini v. New York Times Co.*, 206 F.3d 161 (2d Cir. 1999) (finding publishers cannot place freelance articles in electronic databases because databases containing individual articles from periodicals do not constitute revisions under §201(c)), *aff'd*, 533 U.S. 483 (2001); *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (holding articles republished in electronic databases are not part of, nor revisions, of periodicals and cannot be relicensed by periodical publishers without the author's consent).

3. See MCLUHAN, *supra* note 1 (concluding that since the rise of man, society has been shaped by the manner in which they communicate). The development of the spoken word allowed the transfer of ideas among primitive man; the development of the written word allowed records to be kept and knowledge to be transferred among man's contemporaries as well as future generations; Gutenberg's printing press disseminated the written word to the masses encouraging academia and debate; the development of telephones and radios drastically reduced geographic barriers to communication and allowed information to be quickly spread across the globe; and television and new technologies will transform the world to a "global village" where everyone on the planet is inextricably connected to each other as if we lived in the same village in primitive Africa. *Id.* Throughout these changes, the essence of communications has remained fundamentally the same, focusing on agriculture, commerce, war, etc., yet society has developed as a result in the changes in the way that we communicate. *Id.* See also MARSHALL MCLUHAN & BRUCE R. POWERS, *THE GLOBAL VILLAGE: TRANSFORMATIONS IN WORLD LIFE AND MEDIA IN THE 21st CENTURY* (Oxford Univ. Press 1989) (discussing the effects of modern media on society).

4. The Internet began as "ARPANET," an experimental project of the Advanced Research Project Agency. Needham J. Boddie et al., *A Review of Copyright and the Internet*, 20 CAMPBELL L. REV. 193, 195 (1998). The Defense Advanced Research Agency (DARPA) developed ARPANET to link computers owned by military contractors with university laboratories conducting defense related research. *Id.* As the number of networks increased, DARPA developed rules and procedures, called protocols, for sending and receiving data within the networks. *Id.* As the networks grew in size the networks as a whole came to be known as the "DARPA Internet" which was subsequently shortened just to Internet. *Id.* "The Internet today is a worldwide entity whose nature cannot be easily or simply defined. *Id.* From a technical definition, the Internet is the set of all interconnected 'IP networks' – the collection of several thousand local, regional, and global

community, and unprecedented access to information via the “information superhighway” are confirming McLuhan’s hypothesis.<sup>5</sup> Today, it is the norm to have a digital<sup>6</sup> telephone in your pocket, not only capable of instantly contacting anyone in the world, but also capable of connecting to the Internet to send and receive e-mail, download stock quotes, and check to see what time a movie is playing.<sup>7</sup> Digital communication is revolutionizing the world in which we live.<sup>8</sup>

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computer networks interconnected in real time via the TCP/IP Internetworking Protocol suite. . . .” DANIEL P. DERN, *THE INTERNET GUIDE FOR NEW USERS* 16 (McGraw-Hill 1994). More simply, the Internet is millions of computers in schools, universities, corporations, homes, and other organizations tied together via telephone lines. David Bruning, *Blasting Along the InfoBahn*, *ASTRONOMY*, June 1995, at 76. “The Internet enables users to share files, search for information, send electronic mail, and log onto remote computers. But it isn’t a program or even a particular computer resource. It remains only a means to link computer users together.” *Id.*

5. See Dom F. Atteritano, Note, *The Growing Financial Pie of Online Publications: Tasini’s New-Use Analysis Leaves Freelance Authors Less than Crumbs*, 27 *HOFSTRA L. REV.* 377, 378 (1998) (arguing the same). The term “information superhighway” was coined in 1978 by Mr. Albert Gore, and is used interchangeably with the terms “electronic highway” and “National Information Infrastructure.” Mark L. Gordon & Diana J. P. McKensie, *A Lawyer’s Roadmap of the Information Superhighway*, 13 *J. MARSHALL J. COMPUTER & INFO. L.* 177, 179 (1995). The “information superhighway” is the popular term used to describe a vision of a worldwide communications network, similar to what the Internet is today. *Id.* at 179 n.2 (citing Daniel Pearl, *Colliding Cliches and Other Mishaps on the Term Pike*, *WALL ST. J.*, Feb. 1, 1994, at A5). Personal computers permit instant access to volumes of information from case law, to sports scores, to stock quotes, to instantaneous breaking news. Atteritano, *supra* at 378 n.1. Researchers estimate that in the fourth quarter of 1997, over 62 million people in the U.S. were online and taking advantage of this new technology. *Id.* at n.5. As a result, the United States is amidst unprecedented technological change in which our capacity to produce, transmit, and receive information increases daily. See MARSHALL A. LEAFFER, *UNDERSTANDING COPYRIGHT LAW* 1.1, at 1 (3d ed. 1999).

6. Digital technology can transfer and express text, audio and visual information extremely effectively using bits of data. See Rod Dixon, *Profits in Cyberspace: Should Newspaper and Magazine Publishers Pay Freelance Writers for Digital Content?* 4 *MICH. TELECOMM. TECH. L. REV.* 127, 127 n.1 (1997) (citing PETER NORTON, *INSIDE THE P.C.* at 319-20 (6th ed. 1995)); Sony Media and Energy – *Digital Future*, available at <http://www.sel.sony.com/SEL/rmeg/digitalfuture/> (last visited October 1, 2001). Bits, expressed as either a “1” or a “0”, are the fundamental units of digital technological data. *Id.* The bits “1” and “0” represent on and off switches which allow electrical current to pass through the memory register of a computer or microchip. *Id.* Since binary bits enable easy digital expression and as digital technology expands the amount of data that can be processed on a microchip, digital format has become the format of choice in electronics. *Id.*

7. *Techno Life*, *U.S. NEWS & WORLD REP.*, Dec. 1, 1997, at 68. Digital wireless telephones are actually computers that can access the Internet, send and receive electronic mail, download sports scores in real time, and transmit faxes. *Id.* E-mail, short for electronic mail, is a method of communication via the Internet whereby one can address and transmit a message to one or more people. Boddie, *supra* note 4, at 195.

8. See Atteritano, *supra* note 5, at 378 (discussing the impact of digital technology); Jane C. Ginsburg, *Putting Cars on the “Information Super Highway”: Authors, Exploiters, and Copyright in Cyberspace*, 95 *COLUM. L. REV.* 1466, 1467 (1995) (arguing digital technology makes it easy to make perfect digital copies of works, but copyright law is flexible enough to adequately cope with these new technologies); Sheldon W. Halpern, *The Digital Threat to the Normative Role of Copyright Law*, 62 *OHIO ST. L.J.* 569, 571 (2001) (arguing the digital information infrastructure

Unfortunately the technological revolution has sparked a civil war within copyright law.<sup>9</sup> Congress has periodically, but consistently, modified the copyright laws to respond to the introduction of new technologies affecting copyright.<sup>10</sup> Although Congress passed the Copyright Act of 1976 (hereinafter Copyright Act or 1976 Act) to cope with emerging computer technology, no one anticipated the explosion of digital technology that has marked the dawning of the Information Age.<sup>11</sup>

The overriding purpose of copyright law is “to promote the progress of science and the useful arts.”<sup>12</sup> To achieve this purpose

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makes private infringement easier and detection more difficult thereby making individual standards of moral and ethical conduct more important in copyright law); Dixon, *supra* note 6, at 127 (discussing applicability of traditional copyright principles to new digital formats in which society receives information); April M. Major, *Copyright Law Tackles Yet Another Challenge: The Electronic Frontier of the World Wide Web*, 24 RUTGERS COMPUTER & TECH. L.J. 75, 76 (1998) (discussing how digital technology enables almost anyone to be a publisher); John D. Shuff & Gregory T. Holtz, *Copyright Tensions in a Digital Age*, 34 AKRON L. REV. 555, 557 (2001) (discussing benefits of new technologies); David J. Loundy, *Revising the Copyright Law for Electronic Publishing*, 14 J. MARSHALL J. COMPUTER & INFO. L. 1, 4 (1995) (discussing effect of digital technology on individuals, libraries, the publishing industry, and copyright law).

9. See *Tasini*, 533 U.S. 483; see also *supra* note 8 (examining impact of digital technology on society); *infra* notes 12-17 (examining impact of digital technology on copyright law).

10. See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984) (“From its beginning, the law of copyright has developed in response to significant changes in technology. . . Repeatedly, as new developments have occurred in this country, it has been Congress that has fashioned the new rules that new technology made necessary. . .”); Robert Meitus, *Interpreting the Copyright Act’s Section 201(c) Revision Privilege with Respect to Electronic Media*, 52 FED. COMM. L.J. 749, 753 (2000); Arthur Miller, *Copyright Protection for Computer Programs, Databases and Computer-Generated Works: Is Anything New Since CONTU?*, 106 HARV. L. REV. 977, 982 (1993); text *infra* note 35. When technological change renders the terms of the Copyright Act ambiguous, the Court must construe the Copyright Act to further its underlying purpose; to maximize the general benefits derived by the public from the labors of authors. *Twentieth Cent. Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975), *citing* *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) (asserting the sole interest of the United States in copyright is benefiting the public); see also *Kendall v. Winsor*, 62 U.S. 322, 327 (1858) (stating the ultimate aim of granting a limited monopoly to authors is to stimulate artistic creativity for the general public good); *Grant v. Raymond*, 31 U.S. 218, 241 (1832) (arguing that conferring benefit on the public via creative works is primary purpose of copyright).

11. Copyright Act of 1976, 17 U.S.C. §§ 101-1332 (2002). “Many decades of technological, social and economic changes forced Congress to amend the 1909 Act in a piecemeal fashion. But in 1955, Congress authorized comprehensive hearings and reports that culminated – nearly twenty years later – in the 1976 Act.” Meitus, *supra* note 10, at 754. The 1976 Copyright Act provides protection to all works fixed in a tangible medium of expression regardless of whether it was published; extends copyright protection to the life of the author plus seventy years; guarantees copyright owners five exclusive rights including reproduction, adaptation, public distribution, performance, and display; and allows copyright owners to license or assign the copyright in whole or in part getting rid of indivisibility. *Id.*

12. U.S. CONST. art. I, § 8, cl. 8. The U.S. Constitution grants Congress “the Power . . . to promote the Progress of Science and the useful Arts, by securing for limited Times to authors and

authors are granted a limited monopoly in their works as an economic incentive to create and disseminate their works.<sup>13</sup> This incentive to the authors competes against the fact that to promote the general welfare, the public must also have access to the new works.<sup>14</sup> The author's monopoly inherently restricts access to the works, but absent this limited monopoly there would be little incentive to create and thus fewer works to access.<sup>15</sup> Copyright law delicately balances these competing interests to foster the creation and dissemination of literary and artistic works in order to enhance the public's access to "science and the useful arts."<sup>16</sup>

Digital technology has upset the delicate balance of copyright law by increasing society's access to authors' works via the Internet, and by enabling society to make perfect digital copies of those works.<sup>17</sup> Under the new digital regime, it is increasingly more difficult for authors to enforce their copyrights; while for the first time it is economically

Inventors the exclusive Right to their respective Writings and Discoveries . . ." *Id.* See also, *Twentieth Cent. Music Corp.*, 422 U.S. at 156 (discussing purposes of copyright law); *Fox Film Corp.*, 286 U.S. at 127 (noting purpose of copyright); *Kendall*, 62 U.S. at 328 (stating purposes of copyright); *Grant*, 31 U.S. at 241 (discussing underlying purposes of copyright law).

13. See U.S. CONST. art. I, § 8, cl. 8. See also, *infra* text, at notes 35-38 (looking at history of copyright law).

14. Dixon, *supra* note 6, at 140 (" . . . Courts must balance the constitutionally competing aims of promoting human creativity and original expression through strict enforcement of the copyright law with ensuring that broad copyright protections do not unfairly or unnecessarily prevent the development of our knowledge base – particularly, the nation's development of practical uses of technology and information").

15. See *infra* note 37 (discussing incentives created by copyright system).

16. Shuff, *supra* note 8, at 556. (stating the various copyright statutes enacted over the past 210 years have attempted to equalize the tensions by providing a sufficient incentive to ensure that new works are created while allowing for the broadest public consumption of those works). It is a delicate balance that has shifted over the years to offer greater or lesser protections under the various statutes to achieve the same goals of benefiting the public. *Id.*; see Pamela Samuelson, *Fair Use for Computer Programs and Other Copyrightable Works in Digital Form: The Implications of Sony, Galoob, and Sega*, 1 J. INTEL. PROP. L. 49, 57 (1993).

17. See Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 285 (1996) (arguing digital technology threatens to upset copyright's balance of private ownership and public access because once a work is online anyone, can make perfect digital copies, can make limitless variations, and can disseminate them to the ends of the earth); Halpern, *supra* note 8, at 597 ("The digital technology of recent years has significantly upset what was always a precarious balance and it is likely that further refinements to that technology will give rise to even more serious disruption."); Shuff, *supra* note 8, at 555 ("The rapid and exponential expansion of our ability to duplicate and disseminate information by digital means has rejuvenated inherent tensions in the law pertaining to copyright and has created some new ones."). Cf. *Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 917 (1994) (" . . . widespread availability of photocopying technology threatens to disrupt the delicate balances established by the Copyright Act."), *cert. dismissed*, 116 S.Ct. 592 (1995). Reproduction technologies create a pressing need for "the law to strike an appropriate balance between the authors' interest in preserving the integrity of copyright, and the public's right to enjoy the benefits that [the new technology] offers." *Id.*, citing 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05 (2001).

feasible for publishers and the public to make and sell individual infringing copies of a work.<sup>18</sup> The characteristics of digital technology are changing the underlying assumptions of copyright law and leaving authors, publishers, and users confused as to their rights.<sup>19</sup>

Copyright law finally confronted the Information Age in *New York Times Co. v. Tasini*<sup>20</sup> when the Supreme Court applied copyright law to electronic publishing for the first time.<sup>21</sup> The plaintiffs, six freelance writers, argued that the defendant print publishers infringed their copyrights by placing their freelance articles in electronic databases without the author's permission.<sup>22</sup> The defendants admit placing the articles in the electronic databases without permission, but they claim a privilege to republish the articles as part of a "revision" under §201(c) of the Copyright Act.<sup>23</sup> The Supreme Court held that the articles republished in the electronic databases were not "part of" nor "revisions of" the original periodicals because they were presented individually.<sup>24</sup> Therefore, the freelance articles could not be re-licensed or re-published electronically by the print publishers without the author's consent.<sup>25</sup>

This Note analyzes the Supreme Court's recent opinion in *New York Times Co. v. Tasini* and its implications for the future of copyright law and electronic publishing.<sup>26</sup> Part II of this Note documents the background of copyright law, and details how the default provisions of

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18. Shuff, *supra* note 8, at 557. (explaining digital technology's "astonishingly low threshold of capitalization and technical expertise" allows copying and dissemination at the stroke of a key). "The information infrastructure makes private infringement of intellectual property rights vastly easier to carry out and correspondingly more difficult to detect and prevent." Halpern, *supra* note 8, at 572, *citing* Comm. on Intell. Prop. Rights and the Emerging Info. Infrastructure, Nat'l Research Council, *The Digital Dilemma: Intellectual Property in the Information Age*, at ix (2000) (executive summary reprinted in 62 OHIO ST. L.J. 951 (2001)). The National Commission on New Technological Uses of Copyrighted Works (hereinafter CONTU) concluded that where the cost of duplication is low, copies are more likely to be made; where more copies are likely to be made, legal protection is needed to preserve the incentive to create and disseminate the works that are being copied. Nat'l Comm. on New Tech. Uses of Copyrighted Works 7 (1979).

19. Halpern, *supra* note 8, at 597 (arguing that the nature of modern copyright law obstructs the underlying purposes and fails to give society an unambiguous moral compass). The actions of the average citizen on the Internet regularly violate copyright laws by downloading files, yet society merely thinks of these violations as *mala prohibita* crimes without a victim. *Id.* at 572.

20. *New York Times Co. v. Tasini*, 533 U.S. 483.

21. *Tasini*, 533 U.S. at 483. The Supreme Court decided in favor of the freelance authors in answering the long awaited question of who owns electronic rights to freelance articles. Laurie A. Santelli, Note, *New Battles Between Freelance Authors and Publishers in the Aftermath of Tasini v. New York Times*, 7 J.L. & POL'Y 253, 254 (1998).

22. *Tasini*, 533 U.S. at 487.

23. *Id.*; 17 U.S.C. §201(c) (2002).

24. *Tasini*, 533 U.S. at 483.

25. *Id.*

26. *Id.*; *see infra* Part II-V.

§201(c) govern the publisher-author relationship.<sup>27</sup> Part III of this Note introduces the parties and circumstances surrounding the *Tasini* case.<sup>28</sup> Part III continues by outlining the District Court for the Southern District of New York,<sup>29</sup> the Court of Appeals for the Second Circuit,<sup>30</sup> and the Supreme Court decisions in this landmark case.<sup>31</sup> Part IV of this Note dissects the Supreme Court's interpretation of §201(c)'s "revision" privilege and its application to electronic databases.<sup>32</sup> Lastly, Part V of this Note discusses the consequences of the Supreme Court's decision and the potential effect it will have on electronic publishing and society.<sup>33</sup>

## II. BACKGROUND

### A. Overview of Copyright Law

Gutenberg's invention of the printing press marked the beginning of the mass production of literary works<sup>34</sup> and, consequently, the need for copyright protection.<sup>35</sup> Copyright laws developed in an effort to balance an author's right to his creative works with the public's interest in having access to those works.<sup>36</sup> Copyright law aims to achieve this balance by granting authors exclusive rights in their works so as to encourage them to both create and disseminate their works for the public

27. See 17 U.S.C. § 201(c) (2002); *infra* Part II.

28. See *Tasini*, 533 U.S. 483; *infra* Part III.

29. See *Tasini*, 972 F. Supp. 804; *infra* Part III.

30. See *Tasini*, 206 F.3d 161; *infra* Part III.

31. See *Tasini*, 533 U.S. 483; *infra* Part III.

32. *Tasini*, 533 U.S. 483; see 17 U.S.C. §201(c) (2002); *infra* Part IV.

33. *Tasini*, 533 U.S. 483; see *infra* Part V.

34. "Literary works are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied." 17 U.S.C. § 101 (1994). This includes computer program, computer databases and all digital works. H.R. REP. NO. 94-1476, at 55 (1976).

35. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984) (discussing how copyright protection was not necessary prior to the printing press because hand copying literary works was too costly and time consuming to pose a threat to authors' interests). See also Marshall Leaffer, *Protecting Author's Rights in a Digital Age*, 27 U. TOL. L. REV. 1, 3 (1995) (examining history of copyright law); Yuri Hur, Note, *Tasini v. New York Times: Ownership of Electronic Copyrights Rightfully Returned to Authors*, 21 LOY. L.A. ENT. L.J. 65 (2000) (discussing development of copyright law).

36. Santelli, *supra* note 21, at 258 (explaining how England passed the Statute of Anne, the first copyright statute, in 1710 granting authors the exclusive right to copy their books for fourteen years). The book then became part of the public domain for the public's benefit. *Id.*

good.<sup>37</sup> The Supreme Court acknowledged, “[e]ncouragement of individual effort by personal gain is the best way to advance public welfare through talents of authors and inventors in ‘science and the useful arts.’”<sup>38</sup>

The United States Constitution embodies these ideals by giving Congress “the Power . . . to promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>39</sup> Pursuant to its constitutional authority, Congress has passed numerous comprehensive copyright statutes,<sup>40</sup> the most recent being the Copyright Act of 1976.<sup>41</sup>

Under the 1976 Act, copyrights are granted to original works of authorship in any fixed, tangible medium of expression.<sup>42</sup> The author of

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37. Boddie, *supra* note 4, at 215 (discussing the fundamental purpose of copyright law is to encourage individuals to produce and disseminate creative works to the public). By providing authors with exclusive rights to their works, they will not fear the theft of their work hence promoting dissemination. *Id.* Additionally, these exclusive rights provide an economic incentive to produce new works because the authors can reap the benefits of their efforts. *Id.* See also, 17 U.S.C. § 102(b) (2002).

38. Mazer v. Stein, 347 U.S. 201, 219 (1954); see *infra* note 39 and accompanying text.

39. U.S. CONST. art. I, § 8, cl. 8.

40. Meitus, *supra* note 10, at 753 (discussing how Congress passed the first federal copyright statute in 1790 granting protection to maps, charts, or books for fourteen years with an equal renewal period). General revisions took place in 1831 and 1870. *Id.* In 1909 Congress overhauled the old copyright statute and adopted the 1909 Act which: expanded the subject matter of copyrights; extended the duration of copyrights, and changed the trigger for federal protection to publication instead of registration. *Id.* The 1909 Act was amended throughout the twentieth century to meet social and technological changes, but in 1955 Congress authorized comprehensive hearings and reports that culminated in the Copyright Act. *Id.* See also Michael Spink, *Authors Stripped of Their Electronic Rights In Tasini v. New York Times Co.*, 32 J. MARSHALL L. REV. 409, 418 (1999) (laying out progression of United States’ copyright laws).

41. Copyright Act of 1976, 17 U.S.C. §§ 101-1101 (2002). The 1976 Act provides protection to all “original works of authorship fixed in any tangible medium of expression, now known or later developed from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” 17 U.S.C. § 102 (2002) (stating subject matter of copyright). A work is fixed when its embodiment in a copy or phonorecords is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. 17 U.S.C. § 101 (2002) (defining “fixed”). The 1976 Act does not require the work to be published in order to be protection. See *id.* It extended the duration of protection to the life of the author plus seventy years. 17 U.S.C. § 302 (2002). The 1976 Act guarantees authors five exclusive rights: reproduction, adaptation, public distribution, performance, and display. 17 U.S.C. § 106 (2002). It also allows for divisibility of a copyright through licensing of a copyright in whole or in part. Meitus, *supra* note 10, at 754.

42. Frank H. Smith, *Tasini v. New York Times Co.: A Copyright, or a Right to Copy?*, 32 NEW ENG. L. REV. 1093, 1095 (1998). Under the 1976 Act, Congress has the power to grant a copyright “in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated either directly or with the aid of a machine or device.” 17 U.S.C. § 102 (2002). There are two basic

the work is the original owner of the copyright.<sup>43</sup> The copyright owner is granted a bundle of exclusive rights including the right to reproduce the work, distribute copies, create derivative works, publicly perform the work, and display the work.<sup>44</sup> Each exclusive right is divisible from the

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requirements for copyright protection: originality and fixation. See 17 U.S.C. § 103(b) (2002); Jack B. Hicks, Note, *Copyright and Computer Databases: Is Traditional Compilation Law Adequate?*, 65 TEX. L. REV. 993, 997 (1987). The originality requirement stems from the Court's interpretation of "author" to mean "he to whom anything owes its origin; originator; or maker." *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (holding arrangement of photographic subject sufficiently original to warrant copyright protection), noted in Hicks, *supra* at 997. To meet this low threshold standard the author must contribute something more than a trivial variation; the work must be independently created, not copied, and possesses a minimal degree of creativity. *Burrow-Giles Lithographic*, 111 U.S. at 53 (holding photographic layout and set design sufficiently original for copyright protection); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) (holding advertisements "in their ensemble and in all their details, in their design and particular combinations of figures, lines and colors, are the original work of the plaintiffs' designer"); *Feist Publ'n's Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (holding listing names alphabetically in telephone directory was not sufficiently original to grant copyright protection). Creativity is usually only an issue when the object of copyright is short and is mainly functional. *Goldstein v. California*, 412 U.S. 546, 561 (1973) (inferring some modicum of creativity is required when the Court defined a "writing" as "any physical rendering of the fruits of creative intellectual or aesthetic labor"), quoted in Hicks, *supra*, at 998; *Smith v. George E. Muelebach Brewing Co.*, 140 F. Supp. 729 (W.D. Mo. 1956) (holding a two note musical composition "too simple" for copyright). The fixation requirement means a work must be more than an idea, procedure, process, system, concept, or discovery; it must be an expression of that idea in a tangible form. Hicks, *supra*, at 999; see *Burrow-Giles*, 111 U.S. 53 (1884) (holding photograph falls under copyright law's protection of fixed writings).

43. 17 U.S.C. § 201(a) (1994) (discussing how generally the author is the party who actually creates the work, the party who translates the idea into a fixed, tangible medium of expression). However, the 1976 Act contains an exception whereby "If the work is for hire, 'the employer or other person for whom the work was prepared is considered the author,' and consequently they own the copyright, not the creator." *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989) (holding independent sculptor was not an employee of organization who hired him to make statue, thus the statue was not a work made for hire), citing 17 U.S.C. § 201(b) (2002). In deciding if a work is made for hire, a court must first use principles of the general common law of agency to determine whether an employee or an independent contractor made the work. *Reid*, 490 U.S. at 751. If a work was made by an employee, the court applies § 101(1) which states, "A 'work for hire' is a work prepared by an employee within the scope of his or her employment." 17 U.S.C. § 101(1) (defining work made for hire). If a work was created by an independent contractor, the court can apply § 101(2) that allows the parties to expressly agree in a written instrument that a work is "made for hire" only if the work is, "specially ordered or commissioned for use as a contribution to a collective work, as part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas." *Reid*, 490 U.S. at 751; see also 17 U.S.C. § 101(2) (defining "work made for hire"). The "work made for hire" doctrine is very important to freelance creators because it determines to which works they own copyrights, and to which works their patrons hold the copyrights. *Reid*, 490 U.S. at 737.

44. 17 U.S.C. § 106 (2002); see *Stewart v. Abend*, 495 U.S. 207, 220 (1990) (referring to copyright owner's exclusive rights as a bundle of rights in their work).

others and, therefore, independently transferable.<sup>45</sup> A transfer of one or all of these exclusive rights is valid only if conveyed in writing and signed by the copyright owner.<sup>46</sup>

### B. Authors, Publishers, and Collective Works

A collective work is a work, such as a periodical, newspaper, or anthology, in which a number of contributions, constituting separate and independently copyrightable works, are assembled into a collective whole.<sup>47</sup> “Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution.”<sup>48</sup> Copyright in the collective work as a whole vests in the collective author and only covers the creative material added by that author, not the preexisting material.<sup>49</sup>

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45. 17 U.S.C. § 201(d)(1) (2002). The copyright owner may transfer any exclusive rights individually while retaining ownership of the remaining exclusive rights. 17 U.S.C. § 201(d)(2) (2002). Any one of the exclusive rights may be transferred and owned separately. *Id.*

46. 17 U.S.C. § 204(a) (2002).

47. 17 U.S.C. § 101 (2002) (defining “collective work”). A collective work is a type of compilation. *Id.* A compilation is “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” *Id.* (defining compilation). A compilation may be made of previously copyrighted works or of works/data that is not copyrightable standing alone. Hicks, *supra* note 42, at 1001.

48. 17 U.S.C. § 103(b) (2002) (“Copyright in a compilation or derivative extends only to the material contributed by the author of such a work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting work.”). A magazine publisher has a copyright in the magazine as a collective work, but photographers, advertisers, and freelance writers have separate copyrights in the independent pictures and articles contributed to the magazine. Wendy J. Gordon, *Fine Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 BROOK. L. REV. 473, 479 (2000). Thus a party wishing to copy a magazine must get permission from the copyright owner of the collective work (publisher), and from each of the owners of the copyrights in the individual articles, advertisements, and photographs. *Id.*

49. 17 U.S.C. § 103(b) (2002); *see supra* note 20. Authors of compilations are deemed to contribute originality through selection, coordination and arrangement of the underlying facts or works, thus only granting them copyright protection to these aspects of the compilation. *See* 17 U.S.C. § 101 (2002) (defining compilation); *Feist Publications v. Rural Tel. Serv. Co.*, 499 U.S. 340, 341 (1991) (holding telephone directory not copyrightable because selection was mandated by state law, and alphabetical arrangement was not original). For compilations of preexisting material, the arrangement is often the only contribution of the compiler. Hicks, *supra* note 42, at 1002, *citing* *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*, 351 F.2d 546 (7th Cir. 1965), *cert denied*, 383 U.S. 958 (1966); *Hartfield v. Peterson*, 91 F.2d 998 (2d Cir. 1937); *PIC Design Corp. V. Sterling Precision Corp.*, 231 F. Supp. 106 (S.D.N.Y. 1964); *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35 (7th Cir. 1926), *cert. denied*, 273 U.S. 738 (1926). “Under the arrangement doctrine, if an original (non copied) arrangement of information is chosen and the required quantity of intellectual labor is expended, copyright is deserved.” Hicks, *supra* note 42, at 1002. Subjective selection of

Prior to the 1976 Act, freelance authors risked losing their copyrights when their articles were included in collective works such as newspapers.<sup>50</sup> The 1976 Act addressed this unfair situation so as to preserve an author's rights when he placed his works in compilations.<sup>51</sup> The 1976 Act recast copyright as an exclusive bundle of rights, each of which could be exclusively transferred or owned.<sup>52</sup> When an author includes an article in a collective work, "the owner of copyright in the collective work is presumed to have acquired *only* the privilege of

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what to gather, and what to include in a compilation is another form of copyrightable expression found in compilations. *Id.* at 1005. "The creative effort involved in selecting and compiling such material satisfies copyright's requirement of originality and creativity." *Id.*, citing *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984); *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809, 812 (7th Cir. 1942); *College Entrance Book Co. v. Amsco Book Co.*, 119 F.2d 874, 875 (2d Cir. 1941); *Dow Jones & Co. v. Bd. of Trade*, 546 F. Supp. 113 (S.D.N.Y. 1982). However, compilations substantially similar to the original are not copyrightable. *Hicks*, *supra* note 42, at 1006. Subjective selection is usually only applied to small compilations because the compiler has narrowed the wide range of possible subjects down to a few select components of the compilation. *Id.* Compilations based on objective criteria, such as all telephone numbers in a state, are not protected under the subjective selection doctrine. *Id.*

50. See *Matthew Hoff, Tasini v. New York Times: What the Second Circuit Didn't Say*, 10 ALB. L.J. SCI. & TECH. 125, 132 (1999) (discussing the same). Under the 1909 Copyright Act, a copyright was a single, indivisible right. *Id.* Since there was no partial assignment of copyright, any transfer had to be either a complete transfer of rights, or a mere license. *Id.* The 1909 Act required copyright notice in the name of the copyright proprietor in order to protect the work. *Id.* Since a licensee was not a proprietor, the publisher's copyright notice did not protect freelance writers' articles included in collective works. *Id.* The freelance authors were left with two unacceptable choices: 1) license their articles to be published in a collective work (hoping the publisher might include a separate copyright notice without which the article would fall into the public domain), or 2) transfer the whole copyright to the publisher, thus making him the proprietor and protecting the article (but the author has lost all future rights in the work). *Id.*, at 133. Since publishers rarely included separate copyright notices for contributions, the authors were stuck with transferring the whole copyright or losing their work to the public domain. *Hoff, supra*, at 33. Known as the "Doctrine of Indivisibility," this scheme often led to authors losing all of the rights to their works when they did not intend that result. *Id.*, at 134. In addition, under the 1909 Act, an author could not sue a third party for infringement if they had previously licensed a publisher to use the work. *Id.*

51. *Hoff, supra* note 50, at 134 (discussing how the Doctrine of Indivisibility was widely criticized as being unfair to authors, so courts began to erode the Doctrine). *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 399 (2d Cir. 1970) (holding an author's work did not fall into the public domain as long as there was a copyright notice on the work, even if it was in the publisher's name). The Doctrine of Indivisibility was finally killed by the passage of the Copyright Act of 1976 which recognized copyright as a bundle of divisible, exclusive rights. *Hoff, supra* note 50, at 132. An author could now assign certain rights to a publisher and retain the others to possibly assign in the future. *Id.*

52. 17 U.S.C. § 106 (2002) (owner of copyright has the exclusive rights to do and authorize any of the following: to reproduce, to prepare derivative works, to distribute, to perform, and to display); 17 U.S.C. § 201(d) (2002) ("[t]he ownership of copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.").

reproducing and distributing the contribution as part of that collective work, any revision of that collective work, and any later collective work in the same series.”<sup>53</sup> The 1976 Act also provides that a single copyright notice, applicable to the collective work as a whole, is sufficient to protect the rights of freelance authors in their contributions.<sup>54</sup> Today, copyright law allows freelance authors to resell their articles after their initial publication, thus allowing them to benefit from future demand for their contributions standing alone or in a new collection.<sup>55</sup> Taken as a whole, the Copyright Act was designed to preserve the author’s copyright in his contribution to a collective work.<sup>56</sup>

### III. STATEMENT OF THE CASE

#### A. *Statement of the Facts*

##### Six freelance authors brought suit against print and electronic

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53. 17 U.S.C. § 201(c) (2002) (emphasis added). Owners of copyrights in collective works have a different right than the copyright owner of a contributed article. Charles S. Sims & Matthew J. Morris, *Tasini and Archival Electronic Publication Rights of Newspapers and Magazines*, 18 COMM. LAW. 9, 10 (2001). “The extent of these differing rights for authors and publishers depends on the construction of §201(c).” *Id.* The authors argue §201(c) grants no rights but only a privilege, a non-exclusive and non-transferable license to print each article in the original issue of the periodical and in later versions, limited to the original medium of publication. *Id.* The publishers argue that it is a limited right, which is transferable to other mediums or other parties. *Id.*

54. 17 U.S.C. § 404(a) (2002) (“Notice of Copyright: . . . A separate contribution to a collective work may bear its own notice of copyright, . . . [h]owever, a single notice applicable to the collective work as a whole is sufficient to invoke the provisions of section 401(d) or 402(d) . . . regardless of the ownership of the copyright in the contributions and whether they have been previously published.”). Previously, a single copyright notice on a collective work did not protect the contributing freelance author’s works because the publisher’s notice only applied to works owned by the publisher, therefore licensed works were published without copyright notice and fell into the public domain. *Goodis*, 425 F.2d at 400.

55. *New York Times Co. v. Tasini*, 533 U.S. 483, 497, *citing* *Stewart v. Abend*, 495 U.S. 207, 229 (1990) (“when an author produces a work which later commands a higher price in the market than the original bargain provided, the copyright statute is designed to provide the author the power to negotiate for the realized value of the work.”).

56. H.R. REP. NO. 94-1476, at 122 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659. The House of Representatives Report explains:

The second sentence of section 201(c), in conjunction with the provisions of section 404 dealing with copyright notice, will preserve the author’s copyright in a contribution even if the contribution does not bear a separate notice in the author’s own name, and without requiring any unqualified transfer of rights to the owner of the collective work. This is coupled with a presumption that unless there has been an express transfer of more, the owner of the collective work acquires ‘only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

*Id.*

publishers for copyright infringement when, without express authorization, their articles were included in electronic databases.<sup>57</sup> The plaintiffs in this case were freelance writers who had sold articles to the defendant newspapers and magazines for publication.<sup>58</sup> The defendant print publishers, New York Times Co. (NY Times), Newsday, Inc. (Newsday) and Time, Inc. (Time) engaged the authors as independent contractors through contracts and oral licenses that did not secure the authors' consent to place the articles in an electronic database.<sup>59</sup> The defendant print publishers then licensed the electronic defendants, LEXIS/NEXIS (NEXIS) and University Microfilms International (UMI), to copy and sell the articles via their electronic databases.<sup>60</sup>

NEXIS produces an online database that allows subscribers to access the full-text of any article in their database via a search engine.<sup>61</sup> UMI produces the "N.Y. Times OnDisc" CD-ROM (NYTO) that allows users to search and retrieve full-text articles from past editions of the

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57. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 806 (1997).

58. *Id.* (discussing how the original Plaintiffs were eleven freelance writers and photographers who contributed to the collective works of the print publisher defendants). Only six plaintiffs remained when the district court granted summary judgment including: Jonathon Tasini, Mary Kay Blakley, Barbara Garson, Margot Mifflin, Sonia Jaffe Robbins, and David S. Whitford. *Id.* Jonathon Tasini is the President of the National Writers Union Local 1981. See Patrick O'Connor, *Online Computer Databases and CD-ROMs are not the Electronic Equivalent of Microfilm: Tasini v. New York Times Co., Electronic Revisions and Individual Contributions to Collective Works Under the Copyright Act of 1976*, 15 GA. ST. U.L. REV. 521, 524 (1998). The National Writers Union represents the interests of approximately 4,500 freelance journalists, book authors, poets, technical writers and editorial cartoonists, and funded the plaintiff's action against the print and electronic publishers. *Id.*

59. See *Tasini*, 972 F. Supp. at 809 (discussing how the defendants asserted they had acquired express transfer of the freelancer's rights in the articles, but the district court concluded that no such transfer had taken place). It is also important to note the significance of the authors acting as independent contractors rather than as employees because a work "prepared by an employee within the scope of his or her employment" is a "work made for hire". 17 U.S.C. § 101 (2002). Under the Copyright Act, the employer acquires the copyright in any "work made for hire", thus if an author is an employee, they do not retain any rights in their works. *Id.* at § 201(b); See also Hur, *supra* note 35 (examining "work made for hire" doctrine).

60. *Tasini*, 533 U.S. at 489 (discussing how each print publisher had an agreement with LEXIS/NEXIS where they provided NEXIS with all the individual articles from their print periodicals). The license authorized NEXIS to copy or sell any portion of those texts. *Id.*

61. *Id.* at 490 (describing NEXIS's services). The print publishers and NEXIS place additional coding in each article to facilitate retrieval from the central database. *Id.* Subscribers can then search for articles by author, subject, date, publication, headline, key term words in text, or other criteria. *Id.* The subscriber can then view, download or print the articles that match his search criteria. *Id.* Each article is displayed with a header informing the reader of the original print publication, date, section, initial page number, headline or title, and author. *Id.* Each article is displayed independently without any visible link to other articles from the original periodical. *Id.* The results are in a text-only format where pictures, advertisements, and original formatting features such as font, page placement, and location of continuation pages are lost. *Id.*

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New York Times similar to the NEXIS database.<sup>62</sup> UMI also produces the “General Periodicals OnDisc” CD-ROM (GPO) that contains selected New York Times articles along with thousands of other articles.<sup>63</sup> GPO presents the New York Times Book Review and Magazine sections as image-based files that show the entire page of the periodical in context, rather than just the text of the article like NEXIS and NYTO.<sup>64</sup>

The plaintiffs brought suit in the Southern District of New York claiming that by providing the articles to the electronic databases, the defendant publishers infringed the plaintiffs’ copyrights in the articles they had licensed to the publishers.<sup>65</sup> The defendants contend they are privileged under §201(c) of the 1976 Act to reproduce and distribute the individual works in “any revision of that collective work.”<sup>66</sup> The crux of this case is therefore the Supreme Court’s legal definition of the term “revision,” or more precisely, whether the electronic databases are permissible “revisions” of the individual periodical from which the articles were taken.<sup>67</sup>

*B. The District Court for the Southern District of New York*<sup>68</sup>

The district court granted summary judgment in favor of the defendants holding §201(c) shielded the defendant publishers from liability because the electronic databases were permissible “revisions” of

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62. *Tasini*, 533 U.S. at 490 (describing UMI’s business). NYTO is a text-only system much like the NEXIS database where a header is added but most of the original formatting is lost. *Id.*

63. *Id.* (discussing how New York Times licensed GPO to provide a facsimile of the NY Times Sunday Book Review and Magazine). UMI “burns” the image of the periodical page onto the GPO CD-ROM so an article appears exactly as it appears on the printed page, complete with photographs, captions, advertisements, and other formatting. *Id.* GPO also contains articles from approximately 200 additional publications. *Id.* The CD-ROMs are searched in the same manner as the NEXIS database, and may be viewed, downloaded or printed. *Id.*

64. *Tasini*, 533 U.S. at 491; *see also, supra* note 61 (setting forth how electronic databases function).

65. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 806 (S.D.N.Y. 1997).

66. *Id.* “In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular work, *any revision* of that collective work, and any later collective work in the same series.” (emphasis added). 17 U.S.C. § 201(c) (1994).

67. *Tasini*, 533 U.S. at 499 (describing the same). Webster’s defines “revision” as “1. the act, process, or work of revising; review; re-examination for correction; as, the revision of a book or of a proof sheet; a revision of statutes. 2. the result of revising; a revised form or version, as of a book, manuscript, etc.” WEBSTER’S NEW UNIVERSAL UNABRIDGED DICTIONARY 1552 (2d ed. 1983).

68. *Tasini*, 972 F. Supp. 804.

the original periodicals.<sup>69</sup> First, the court rejected two of the defendants' claims that some plaintiffs expressly transferred their electronic rights.<sup>70</sup> Next, the court found their § 201(c)'s "revision" privilege was transferable, included display rights, and need not be in the same medium as the original.<sup>71</sup> Finally, the court held that the electronic databases "reproduced and distributed" the author's works "as part of . . . [a] revision of that collective work" to which the authors had originally contributed.<sup>72</sup>

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69. *Id.* (discussing the District Courts reasoning). Summary Judgment is required when "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." FED. R. CIV. P. 56(c). The moving party has the initial burden of informing the court of the basis of its motion and identifying the matter it believes demonstrates the absence of a genuine issue of material fact. *Celotex v. Catrett*, 477 U.S. 317, 323 (1986). Once a party satisfies its initial burden, the nonmoving party must identify specific facts showing there is a genuine issue for trial. FED. R. CIV. P. 56(e). The court must resolve any factual ambiguities in favor of the nonmovant. *Tasini*, 972 F. Supp. 804, 810, *citing* *McNeil v. Aguilos*, 831 F. Supp. 1079, 1082 (S.D.N.Y. 1993).

70. *Tasini*, 972 F. Supp. at 810 (discussing how *Newsday* and *Sports Illustrated* claimed that some plaintiffs expressly transferred their electronic rights to the print publishers). Section 204(a) of the Copyright Act states "a transfer of copyright ownership . . . is not valid unless an instrument or conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent." 17 U.S.C. § 204(a) (2002). *Newsday* asserted the checks used to pay plaintiffs had an agreement on the back that, if cashed, granted *Newsday* the "right to include [plaintiff's articles] in electronic library archives." *Tasini*, 972 F. Supp. at 810. The district court noted: 1) there was no prior agreement or mutual consent concerning the electronic rights (i.e. articles were published before authors received checks), 2) the legends were ambiguous and don't reflect an express transfer of electronic rights, and 3) archives and "electronic libraries", one of which *Newsday* maintained itself, do not include selling the articles to a commercial database such as NEXIS. *Id.* at 810-11. *Sports Illustrated* claimed they had the right to publish the articles in electronic form under Section 10(a) of its contracts that granted them the right "first to publish". *Id.* However, the court rejected this claim because the articles were "first" published in print forty-five days prior to them being published electronically. *Id.* at 812. The district court could not find that any of the plaintiffs expressly transferred electronic rights in their articles. *Id.*

71. *Tasini*, 972 F. Supp. at 815 (discussing how the district court reasoned it was permissible for the print defendants to transfer the § 201(c) privilege to the electronic defendants because "the aim of § 201(c)—to avoid the unfairness of indivisibility—would not be further served" by making the privilege non-transferable). Rather the court treated the privilege as a divisible portion of copyright that could be individually and separately transferred. *Id.* Further, the court found no support for the plaintiff's claim that the legislative history of § 201(c) only intended to allow revisions and reproductions in the same medium as the original. *Id.* The court noted, and both parties conceded, that microfilm archives of newspapers are acceptable "revisions" under § 201(c) although they are in a different medium. *Id.* Lastly, the court held although § 201(c) only grants the right to reproduce the work as a revision, it implicitly includes the right to display the work since a work cannot be displayed electronically without being displayed on a screen. *Id.* at 816.

72. *Tasini*, 972 F. Supp. at 806; *see* 17 U.S.C. § 201(c). The defendants are only permitted to place plaintiff's articles into revisions of those collective works in which the articles first appeared, not "new anthologies" or "entirely different magazines or other collective works." *Tasini*, 972 F. Supp. at 806, *citing* H.R. Rep. No. 94-1476, at 122 (1976). Compilations and collective works, such

The district court used a two-step analysis to determine whether the databases qualified as “revisions.”<sup>73</sup> First, the district court identified the distinguishing characteristics that rendered the defendant’s collective work original.<sup>74</sup> Second, the court determined whether these characteristics were preserved in the alleged revision, or rather whether the two works were “substantially similar.”<sup>75</sup> The district court found the databases preserved the print publishers’ “selection” of articles by including all of the articles originally assembled by the print publishers.<sup>76</sup> Additionally, the databases “highlighted the connection

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as defendant’s periodicals, are characterized by the fact that they have relatively little originality, thus if defendants change the original selection and arrangement of their newspapers, they are at risk of creating new works no longer recognizable as versions of the original periodicals. *Id.* When “revising” their periodicals, defendants must preserve some significant original aspect of those original works, whether selection or arrangement, in order to satisfy the requirements of § 201(c). *Id.* The district court concluded that “it is only if such distinguishing original characteristic remains that the resulting creation can fairly be termed a revision of that collective work which preceded it.” *Id.* at 821.

73. *Tasini*, 972 F. Supp. at 821 (discussing the same). The court’s two-step analysis is derived from the “substantial similarity” test used for determining infringement of collective works. *Id.* at 822. In determining infringement of collective works, “courts begin by determining whether the plaintiff’s compilation exhibits sufficient originality to merit protection; if there is sufficient originality in either selection or arrangement, it is necessary to determine whether these original elements have been copied into the allegedly infringing work.” *Tasini*, 972 F. Supp. at 821. A defendant infringes the Plaintiff’s copyright when he copies the original aspects of a protected collective work so extensively so as to render the “offending and copyrighted works substantially similar.” *Id.*, citing *Lotus Development Corp. v. Borland Intern. Inc.*, 49 F.3d 807, 813 (1st Cir. 1995). The district court reasoned that the current case should use this test reciprocally whereby if the original selection or arrangement of materials is preserved, the electronic reproductions are permissible revisions of “that collective work”. *Id.* at 822. But, if the original aspects of selection or arrangement are not preserved, the electronic reproductions are impermissibly exploiting plaintiff’s rights in the underlying works. *Id.*

74. *Id.* at 821. The factors for originality are derived from the Copyright Act’s definition of a “compilation”, it is a work formed by the collection and assembly of preexisting materials or of data that are *selected, coordinated, or arranged* in such a way that the resulting work as a whole constitutes an original work of authorship” (emphasis added). 17 U.S.C. § 101 (2002); *Feist Publications v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991) (concluding most compilations reflect sufficient originality in selection and arrangement to merit copyright protection, but not every selection, coordination, or arrangement will” be sufficiently original, i.e. alphabetical order).

75. *Tasini*, 972 F. Supp. at 823. A subsequent work must preserve more than a “certain percentage” of the original selection of materials. *Id.*, citing *Worth v. Selchow & Richter Co.*, 827 F.2d 569, 573 (9th Cir. 1987) (holding defendants trivia game did not copy selection of facts from trivia book because game only used a fraction of those facts). The subsequent work must not differ in selection by “more than a trivial degree” from the earlier work. *Id.*, citing *Kregos v. Associated Press*, 937 F.2d 700, 710 (2d Cir. 1991) (holding copying six of nine statistic categories is not infringement). The district court did not focus on what was different between the two works, but rather focused on what the publishers retained in their alleged revisions. *Id.* at 824.

76. *Tasini*, 972 F. Supp. at 823 (discussing the same). The court reasoned that a defining element of the defendant’s publications is the selection of the articles included in those works. *Id.* The New York Times, in identifying “all the news that’s fit to print,” performs a highly subjective

between plaintiff's article and the hard copy periodicals" in tags that identify the article's original location in a particular publication.<sup>77</sup> Thus, the electronic databases were deemed "revision[s]" under §201(c) because they contained "recognizable versions of the publishers' newspapers and magazines."<sup>78</sup>

The district court denied the freelance authors' motion for reconsideration in an opinion clarifying its previous opinion.<sup>79</sup>

### C. *The Court of Appeals for the Second Circuit*<sup>80</sup>

On appeal, the Second Circuit reversed the district court's decision.<sup>81</sup> The Second Circuit rejected the district court's analysis by recognizing the databases do almost nothing to preserve the

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selection process that actually defines the character of the paper and distinguishes it from others. *Id.* The print publisher's selection is preserved electronically because the articles would not have appeared online had it not been for their selection to be in the New York Times, and the print publisher's entire selection of articles is included in the electronic databases. *Id.*

77. *Id.* at 824 (discussing the same). The district court noted that the electronic databases repeatedly identify the publication from which each article was taken thus enhancing the value of that article. *Id.* An article "tagged" as from the New York Times "is instantly imbued with a certain degree of credibility that might not exist in the case of an article never published, or an article published in other periodicals." *Id.* at 824 n.14. The credibility and value that an article gains from being published in a noteworthy publication is retained in the electronic publications due to the print publisher's selection. *Id.*

78. *Id.* at 825.

79. *Tasini v. New York Times Co., Inc.*, 981 F. Supp. 841, 843 (1997) (discussing how plaintiffs filed a motion for reconsideration, raising a number of objections to the district court's approach in its opinion). First, plaintiffs argue that the court should have ruled for the freelance author because the court rejected Time Inc.'s claim that it had acquired electronic rights via one of the contract. *Id.* The district court clarified that simply because a freelancer did not contract away his electronic rights, this fact does not impact the publisher's privilege to reproduce revisions of their periodicals, absent an express transfer of rights. *Id.* at 845. Second, plaintiffs argue that under the court's interpretation of § 201(c), there remains a disputed question of fact as to whether any of the electronic technologies involved in this case qualify as permissible revisions. *Id.* at 843. The court restated the established fact that selection was preserved and that all of the print articles were included in the databases therefore making the print and electronic publications substantially similar as a matter of law. *Id.* at 849. Finally, plaintiffs argue that the court mistakenly didn't seriously consider plaintiff's infringement claim arising from abstracts of the freelance articles in GPO. *Id.* at 843. The court noted the text-based NEXIS and NYTO both qualified as revisions, therefore text-based abstracts in GPO are also permissible revisions of the original work. *Id.* at 851.

80. *Tasini v. New York Times Co.*, 206 F.3d 161 (2d Cir. 1999).

81. *Id.* at 172 (discussing the same). The authors argued on appeal that § 201(c) only allowed publishers to include their works in the original collective work and does not allow individually copyrighted works to be included in one or more electronic databases. *Id.* at 165. The authors also argued that the publisher's privilege under § 201(c) is not transferable to the electronic publishers. *Id.* The Second Circuit held that § 201(c) does not permit publishers to license individually copyrighted works for inclusion in electronic databases. *Id.* Consequently, the court did not address whether the privilege was transferable under § 201(d). *Id.*

copyrightable aspects of the publisher's collective works.<sup>82</sup> The court concentrated on how the enormous electronic databases engulfed the individual articles and periodicals.<sup>83</sup> The Second Circuit found the databases were primarily used to provide the end users with access to "the preexisting materials that belong to the individual author."<sup>84</sup> The court noted "§201(c) would not permit a Publisher to sell a hard copy of an Author's article directly to the public even if the Publisher also offered for individual sale all of the other articles from the particular edition. We see nothing in the revision provision that would allow the Publishers to achieve the same goal indirectly through NEXIS."<sup>85</sup>

Additionally, the Second Circuit addressed the parties' interpretation of the term "revision."<sup>86</sup> The court reasoned that since §201(c) was adopted to end "indivisibility"<sup>87</sup> and preserve an author's rights in his contributions, the defendants' overly broad reading of the term "revision" "would cause the exception to swallow the rule."<sup>88</sup> The

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82. *Id.* at 168 (discussing the same). Some of the paper's content and most of the paper's arrangement are lost when a particular edition of a magazine or newspaper is placed in an electronic database. *Id.* at 169. It is actually difficult for the users of the databases to reconstruct the original periodical or collect all of the articles from a particular edition. *Id.* In fact, The New York Times forbids NEXIS from producing "facsimile reproductions" of particular editions. *See Tasini*, 533 U.S. 483 (2001).

83. *Tasini*, 206 F.3d at 168 (stating "NEXIS is a database comprising thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals. It can hardly be deemed a 'revision' of each and every edition of every periodical that it contains").

84. *Id.* at 169 (discussing the same). Section 201(c) and § 103(b) provide that the author of the individual contribution retains all rights in his work, and may sue for infringement of that work. *Id.*

85. *Id.* at 168.

86. *Id.* at 167, *citing* Exch. Comm'n v. National Sec., Inc., 393 U.S. 453, 466 (1969) (noting that proper statutory construction mandates that particular phrases be interpreted in context). Applying this rule to § 201(c), the court found:

The first clause sets the floor so to speak, of the presumptive privilege: the author of the collective work is permitted to reproduce and distribute individual contributions as part of "that particular collective work." In this context "that particular collective work" means a specific edition or issue of a periodical. The second clause expands on this, to permit the reproduction and distribution of the individual contribution as part of a "revision" of "that collective work," i.e., a revision of a particular edition of a specific periodical. Finally, the third clause sets the outer limit or ceiling on what the publisher may do; it permits the reproduction and distribution of the individual contribution as part of a "later collective work in the same series," such as a new edition of a dictionary or encyclopedia.

*Id.* at 167; 17 U.S.C. § 201(c) (1994).

87. *See supra* notes 50-51 for a discussion of the "Doctrine of Indivisibility."

88. *Tasini*, 206 F.3d at 168, *citing* Commissioner v. Clark, 489 U.S. 726, 739 (1989) (when a statute sets forth exceptions to a general rule, we generally construe the exceptions "narrowly in order to preserve the primary operation of the provision"). Section 201(c) was a key player in eradicating the doctrine of indivisibility in the Copyright Act by explicitly stating that absent and

court also noted the publisher's interpretation conflicted with accepted canons of statutory construction by failing to construe §201(c) in such a manner so as to give meaning to each of its parts.<sup>89</sup> Consequently, the Second Circuit adopted a more narrow definition of "revision" and held the electronic databases were not permissible "revisions" of the individual periodicals.<sup>90</sup>

#### D. *The United States Supreme Court*<sup>91</sup>

The Supreme Court, with a seven justice majority, affirmed the Second Circuit Court of Appeal's decision holding the freelance articles republished in the electronic databases are not "part of", nor "revisions of", the print periodicals, and therefore cannot be re-licensed without the author's consent.<sup>92</sup>

The Supreme Court rejected the publisher's argument that the databases are "revisions" because the articles are individually retrieved and individually displayed to the user absent their original context.<sup>93</sup>

express transfer of rights, the authors retain all rights to their contributions placed in collective works. *Id.* The second sentence of § 201(c) sets out the three exceptions to this general rule. *See* 17 U.S.C. § 201(c) (1994). Therefore, the court held that they should narrowly construe the exceptions so as to "preserve the primary operation of the provision," to preserve the author's rights in their contributions to collective works. *Clark*, 489 U.S. at 739; *Tasini*, 206 F.3d at 168.

89. *Id.* at 167. First, the court reasoned that if the contents of an electronic database are revisions of the collective work, then the last clause of § 201(c), allowing the reproduction of individual works "as part of a later collective work in the same series" would be superfluous. *Id.*, *citing* *Regions Hosp. v. Shalala*, 522 U.S. 448 (1998). An electronic database contains thousands of editions from hundreds of periodicals; to view the contents of this database as a revision of each of those editions would eliminate any need for a privilege for "a later collective work in the same series." *Id.* at 167. Rather, the court interpreted § 201(c)'s three privileges as the floor, middle, and ceiling of publishers' rights. *See supra* note 86.

90. *See supra* notes 81-89. Additionally, the court relied on legislative history that noted the "revision" and "later collective work in the same series" clauses of § 201(c) were not intended to permit the inclusion of previously published freelance contributions "in a new anthology or an entirely different magazine or other collective work." H.R. REP. NO. 94-1476 at 123 (1976). The court concluded that because each database contained innumerable articles from outside publishers and/or editions, the databases were "at best a new anthology of innumerable editions . . . and at worst a new anthology of innumerable articles from these editions." *Tasini*, 206 F.3d at 167.

91. *New York Times Co. v. Tasini*, 533 U.S. 483 (2001).

92. *Id.* at 493.

93. *Id.* at 499-500. Copyright is very concerned with perception as is evidenced in the fixation requirement ("a work is fixed . . . when its embodiment . . . permit[s] it to be perceived . . ."), and the definition of copyrightable subject matter ("original works of authorship fixed in any tangible medium . . . from which they can be perceived . . ."). Alice Haemmerli, *Symposium on Electronic Rights in International Perspective, Commentary: Tasini v. New York Times Co.*, 22 COLUM.-VLA J.L. & ARTS 129, 142-43 (1998); *See also, Tasini*, 533 U.S. at 499 (focusing on perception of the user to determine if electronic database is a revision). Consequently, the Court gave great weight to the manner in which the common user was able to perceive the

The Court stated, “it would scarcely preserve the author’s copyright in a contribution if a newspaper or magazine publisher were permitted to reproduce or distribute copies of the author’s contribution in isolation.”<sup>94</sup> The Court also rejected the publisher’s claim that “media neutrality” allowed the transfer of freelance articles into the electronic databases.<sup>95</sup> The Court’s reasoning distinguished the transfer of newspapers to microfiche, a permissible revision, from the transfer to electronic databases because microfiche converts the original periodicals into the new media intact, while the databases strip the articles of their original context.<sup>96</sup> Lastly, the Court dismissed the publishers’ policy argument that finding for the freelance authors would leave “gaping holes in the electronic record of history” when unauthorized articles were deleted from the databases.<sup>97</sup> The Court noted this speculative prediction was

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freelance articles. *Id.* The Court found the databases “present articles to users clear of the context provided either by the original periodical or by any revision of those editions,” because database “searches” retrieved articles as individual results, and displayed them without the graphics, formatting, or other articles with which the article was initially published. *Id.* at 500. The GPO CD-ROM presented the articles in context as a visual image of the original page, but the database still lacked all of the other material and formatting from surrounding pages of the original periodical. *Id.* At best, the databases were new collective works made up of thousands of individual editions, each of which makes up only a tiny portion of the larger work. *Id.* From another point of view, the articles are not “part of” a larger work at all, but stand as individual works, presented individually. *Id.* Therefore the individual articles were not reproduced and distributed “as part of” either the original edition or a revision of that edition. *Id.*

94. *Tasini*, 533 U.S. at 497; see Gordon, *supra* note 48, at 484-485. The Court noted the Copyright Act “adjusts a publisher’s copyright in its collective work to accommodate a freelancer’s copyright in her contribution. If there is demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand.” *Tasini*, 533 U.S. at 497. The Court disregarded the significance of the identifying “tags” that cited the source of origin because they merely suggest the articles were previously part of that periodical, and do not mean the articles are currently part of that periodical. *Id.* Thus, the databases impermissibly reproduced and distributed the articles individually. *Id.* at 500.

95. *Tasini*, 533 U.S. at 502. The concept of media neutrality is based in Copyright Act’s § 102(a) that grants copyright protection to original works “fixed in any tangible medium of expression.” *Id.* The transfer of a work between media does not alter the character of that work for copyright purposes. *Id.* However, the Court held the transfer to electronic databases does not represent a mere conversion of intact periodical from one medium to another like microfiche. *Id.*

96. *Tasini*, 533 U.S. at 502. Microfilm and microfiche contain continuous photographic reproductions of a periodical in the medium of miniaturized film whereby the articles appear in precisely the same position as in the original periodical, both on the page and within the larger periodical as a whole. *Id.* Although microfilm rolls contain numerous editions (like the databases) and the user can focus on just one article (like the databases), the microfilm distinguishes itself by presenting the articles in their original context of the periodical as a whole. *Id.* On the other hand, NEXIS and NYTO individually present the articles disconnected from the rest of the page and from the rest of the edition. *Id.* GPO presents the articles within the context of the page, but disconnected from surrounding pages, the rest of the Sunday Magazine, and the rest of the newspaper. *Id.* at 501.

97. *Tasini*, 533 U.S. at 505. The publishers and Dissent argue that it will be both difficult and

not a foregone conclusion, and policy considerations such as these are better suited for Congressional lawmaking.<sup>98</sup> The Court remanded the remedies issue back to the district court for hearing and decision.<sup>99</sup>

The majority concluded that the databases did not constitute revisions under §201(c).<sup>100</sup> Therefore, the electronic publishers infringed the freelance authors' copyrights by reproducing the articles in the databases, and the print publishers infringed the authors' copyrights by authorizing the electronic publishers to do so.<sup>101</sup>

#### IV. ANALYSIS

##### A. Defining "Revision"

*Tasini* gave the courts an opportunity, once again, to try their hand at interpreting the notoriously imprecise language of a federal statute.<sup>102</sup>

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costly for the print and electronic publishers to locate and contract with each individual author of the numerous freelance articles in the databases. *Id.* at 520. Without express authorization, the publishers are left vulnerable to potential statutory damages for infringement. *Id.* Publishers may find it more economically feasible to purge their databases of all existing freelance articles and demand a complete transfer of copyright in future freelance articles. *Id.* Consequently, the freelancers would be in the same unfair position as before the 1976 Copyright Act where they lost the copyright to contributions to collective works. *Id.* Further, the wholesale deletion of freelance articles defeats the underlying benefits that electronic databases provide to society: efficiency, accuracy and comprehensiveness. *Id.* This threat, if realized, would defeat copyright law's basic purpose of promoting the general welfare through access to new works. *Id.*

98. *Tasini*, 533 U.S. at 505-06. "Speculation about future harms is no basis for this Court to shrink the authorial rights congress has established in § 201(c)." *Id.* The Court reassured the parties that, "it hardly follows from today's decision that an injunction against the inclusion of these articles in the databases (much less all freelance articles in any databases) must issue." *Id.* at 505, citing 17 U.S.C. § 502(a) (1994) (a court may enjoin infringement); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994) (goals of copyright law are "not always best served by automatically granting injunctive relief"). The Court speculated that the parties may enter into blanket licensing agreements that would enable the publishers to continue using the works while the authors are compensated for the use of the works. *Id.* at 505; see, e.g., *Broadcast Music, Inc. v. Columbia Broadcasting Sys. Inc.*, 441 U.S. 1, 4-6 (1979) (discussing blanket licensing and consent decrees). Further the Court pointed out that numerous other nations, applying their own copyright laws, concluded electronic database reproduction and distribution of freelance works violate copyrights of the freelancers. *Tasini*, 533 U.S. at 506, citing *Union Syndicale des Journalistes Franais v. SDV Plurimdia (T.G.I., Strasbourg, Fr., Feb. 3, 1998)*, in *Lodging of International Federation of Journalism as Amicus Curiae*; *S.C.R.L. Cent. Station v. Ass'n Generale des Journalistes Professionnels de Beligique (CA, Brussels, Belg., 9e ch., Oct. 28, 1997)*, transl. and ed. in 22 COLUM.-V.L.A. J.L. & ARTS 177, 195 (1998); *Heg v. De Volkskrant B.V. (Dist. Ct., Amsterdam, Neth., Sept. 24, 1997)*, transl. and ed. in 22 COLUM.-V.L.A. J.L. & ARTS 177, 181.

99. *Tasini*, 533 U.S. at 506.

100. *Id.*

101. *Id.*

102. *Tasini*, 533 U.S. 483; see Copyright Act of 1976, 17 U.S.C. §§ 101-1332 (2002).

The Supreme Court's decision in *Tasini* rested on how the Court chose to define "revision" as found in §201(c) of the Copyright Act.<sup>103</sup> Justice Ginsburg, writing for the majority, used Webster's Third New International Dictionary to define "revision" as "a new 'version,' and a version is, in this setting, a 'distinct form of something regarded by its creators or others as one work.'"<sup>104</sup> Each court that examined this issue agreed that a revision is inherently different from the original work; but each also agreed it must still be recognizable as a version of the original work.<sup>105</sup>

The Supreme Court's inquiry into whether the articles were republished as "part of" a "revision" . . . focus[ed] on the Articles as presented to, and perceptible by, the user of the Databases."<sup>106</sup> The Court repeatedly struck down the publishers' arguments with the same dual edged sword: ". . .the user sees the article clear of the context provided by the original periodical edition or any revision. . ." and, ". . . the databases do not perceptibly reproduce articles as 'part of' the collective work. . . or as part of any 'revision' thereof."<sup>107</sup> Thus, the

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103. 17 U.S.C. § 201(c) ("In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular work, any revision of that collective work, and any later collective work in the same series.") (emphasis added). Supreme Court also looked to the legislative history of the 1976 Act that indicated the owner of the preexisting work would continue to have the right to sue for infringement even after that work was incorporated into a derivative or collective work. Smith, *supra* note 42, at 1104, citing *Stewart v. Abend*, 495 U.S. 207 (1990).

104. *Tasini*, 533 U.S. at 500, citing WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1944, 2545 (1976).

105. See *Tasini*, 533 U.S. 483; *Tasini v. New York Times, Co.*, 206 F.3d 161 (2d Cir. 1999); *Tasini v. New York Times, Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997); *Greenberg v. National Geographic Soc'y*, 244 F.3d 1267 (11th Cir. 2001). A "revision" can be quite different from the original but must still be recognizable as a version of a preexisting collective work to be fairly called a revision of "that collective work." 17 U.S.C. § 201(c); see *Tasini*, 972 F. Supp at 820. If the alleged revision is not recognizable as a version of the original, it is inherently a completely new work. See *Id.* This new work would not be protected under the § 201(c) "revision" privilege because the legislative history of the 1976 Act clearly states, a "publishing company could reprint a contribution from one issue in a later issue of its magazine and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work." H.R. REP. NO. 94-1476, at 122-123 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5738.

106. *Tasini*, 533 U.S. at 499, citing 17 U.S.C. § 102 (stating copyright protection exists in original works fixed in any medium "from which they can be perceived, reproduced, or otherwise communicated"); § 101 (defining "copies" as material objects in which a work is fixed from which the work can be perceived, and "fixed" as sufficiently permanent or stable to permit it to be perceived). See also Alice Haemmerli, *Symposium on Electronic Rights in International Perspective, Commentary: Tasini v. New York Times Co.*, 22 COLUM.-VLA J.L. & ARTS 129 (1998) (noting Court's focus on perception in interpreting 1976 Act).

107. *Tasini*, 533 U.S. at 499-500. The Court summarily concluded that the articles were

Court concluded the databases were not recognizable versions of the original periodical editions.<sup>108</sup>

Although the Supreme Court ultimately reached a just decision using context and perception as a standard, it failed to adequately address the real issue: What qualifies as a “revision,” or rather when is a work a recognizable version of the original?<sup>109</sup> Following the Court’s analysis, if an article is presented in context, it is a revision; if it is not presented in context, then it is not a revision.<sup>110</sup> However, presentation and arrangement are not the sole defining characteristics of a collective work.<sup>111</sup> In *Feist*, the Supreme Court held that the selection, arrangement, and coordination of the underlying components make a collective work unique and recognizable.<sup>112</sup> A court should look to a collective work’s selection, arrangement, *and* coordination when determining whether the work is a recognizable “revision” of the original periodical.<sup>113</sup> Therefore, a database may be deemed a “revision” if it retains recognizable selection, recognizable arrangement, *or*

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neither “part of” the original work, nor “part of” a “revision” of the original work because they are presented to the users “clear of the context provided by the original periodical editions or by any revision of those editions.” *Id.* The Court used lack of context to strike down the publisher’s argument that the databases were “revisions” of the original periodical, and the publisher’s argument that the databases were akin to microfiche, which is a permissible use under the doctrine of media neutrality. *Id.*

108. *See id.*; see text *supra* Part III.D.

109. *See Tasini*, 533 U.S. 483.

110. *Tasini*, 533 U.S. at 499-500.

111. *See Feist Publ’ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (holding compilations of fact are copyrightable, but a telephone directory, arranged in traditional alphabetical order, was not copyrightable due to lack of minimal creative spark required for compilation copyright). The Court reasoned that a compilation is not copyrightable per se, but is copyrightable only if the underlying components have been “selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” *Id.* at 356, *citing* 17 U.S.C. § 101.

112. *Feist*, 499 U.S. at 348. *See also*, *Bell South Advertising & Pub. Corp. v. Donnelley Info. Pub. Inc.*, 999 F.2d 1436 (11th Cir. 1993) (holding BAPCO’s selection of headings and arrangement of business listings under those headings made the yellow pages sufficiently original), *cert. denied*, 510 U.S. 1101 (1994); *Key Pub., Inc. v. Chinatown Today Pub. Enterprises*, 945 F.2d 509 (2d Cir. 1991) (holding Key directory is original because of the selection of businesses to include and the arrangement of the listings under unique headings); Paula Baron, *Back to the Future: Learning From the Past in the Database Debate*, 62 OHIO ST. L.J. 879, 879 (2001) (discussing “pre-modern” copyright cases protection of databases).

113. *See Tasini v. New York Times Co.*, 972 F. Supp. 804, 820 (1997). Publishers are not allowed to revise the freelance authors contributions to the collective work, so the only parts of a collective work that can be “revised” are the elements of selection, coordination, and arrangement that the collective authors contributed to make it original. *Id.* It is this original contribution that gives a collective work its unique character, which makes it identifiable as “that collective work.” *Id.* Thus to determine whether something is a revision, one should look to the original contributions of the author. *Id.*

recognizable coordination.<sup>114</sup>

The *Tasini* Court admittedly focused on the arrangement and presentation of the articles to database users.<sup>115</sup> The Court correctly found that the electronic databases do not contain any recognizable arrangement from the periodicals.<sup>116</sup> Based on this fact, the Court summarily declared that the databases were not recognizable revisions under §201(c).<sup>117</sup> However, the Court's analysis overlooked the publisher's selection, only looking at the arrangement and coordination of the electronic databases through "context."<sup>118</sup> As a result of this leap in reasoning, the Court ignores the very real possibility that selection alone may render a database a recognizable "revision" of a print periodical.<sup>119</sup>

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114. *See supra* notes 112-13; *Key Pub.*, 945 F.2d at 513 (stating compilation only needs original selection, coordination, "or" arrangement); 17 U.S.C. § 101 (defining compilation as a work formed by assembling preexisting materials that are selected, coordinated, "or" arranged in such a way that the resulting work as a whole constitutes an original work).

115. *Tasini*, 533 U.S. at 499 ("[W]e focus on the Articles as presented to, and perceptible by, the user of the Databases.").

116. *Id.* at 500. "When a user conducts a search, each article appears as a separate item within the search result." *Id.* Articles also appear without graphics, formatting, or other articles with which the article was initially published. *Id.*

117. *Id.*

118. *See id.*; Haemmerli, *supra* note 93, at 142 ("Because the arrangement of the publishers' works is completely lost in the Lexis/Nexis context, the sole issue with regard to Lexis/Nexis is whether the selection of the component parts is recognizable online, thereby qualifying the electronic publication as a 'revision' of the collective work."); Dixon, *supra* note 6, at n.47 (district court never acknowledged that NEXIS contains thousands of articles never selected by the publishers of the New York Times); Hicks, *supra* note 42, at 1006 (noting it is unfortunate that subjective selection receives limited application).

119. *Ethan R. York, Warren Publ'g, Inc. v. Microdos Data Corp.: Continuing the Stable Uncertainty of Copyright in Factual Compilations*, 74 NOTRE DAME L. REV. 565, 584 (1999) (noting originality must be found in the compilers selection or arrangement; there need not be originality found in each aspect of the work); Hicks, *supra* note 42, at 1025 ("Once a court uncovers elements of a databases that reflect subjectivity in their selection, copyright protection follows, regardless of their arrangement or location."). *See also*, Russell G. Nelson, *Seeking Refuge From A Technology Storm: The Current Status of Database Protection Legislation After the Sinking of the Collections of Information Anti-Piracy Act and the Second Circuit Affirmation of Matthew Bender & Co. v. West Publishing Co.*, 6 J. INTELL. PROP L. 453 (1999) (discussing copyright originality in compilations). Although arrangement and coordination are lost, there is no compelling reason why a collection of digital files corresponding to a single edition of the New York Times, standing alone cannot constitute a "revision" of that day's New York Times because selection is retained. *See Tasini*, 533 U.S. at 511 (Stevens, J., dissenting). For example, should the New York Times be forbidden from selling a CD-ROM that contains just today's paper to customers who want to read the Times on their computer? *See id.* This CD-ROM may have a search function to take John Doe directly to the sports scores, and would likely present the articles individually, clear of the context of the rest of the paper, yet, is this CD-ROM anything less than the February 11, 2002 New York Times in a new format? *See id.* The CD-ROM is, in the Supreme Court's own words, "a new 'version,' and a version is, in this setting, a 'distinct form of something regarded by its creators or

Unfortunately for the publishers, utilizing selection, in addition to arrangement, as a basis for recognizing a work as a revision does not change the results of this case.<sup>120</sup> The New York Times is independently recognized for its selection of articles.<sup>121</sup> However, the Court should have examined each database's subjective selection to see if it was similar to the New York Times' selection, thus rendering the database a recognizable revision.<sup>122</sup>

### 1. NEXIS

The subjective selection that goes into NEXIS is fundamentally different from the selection made by the New York Times publishers.<sup>123</sup> The Times publishers decide which articles will be included in "All the News That's Fit to Print."<sup>124</sup> On the other hand, the NEXIS publishers are choosing which periodicals will be included in their database.<sup>125</sup> Once the NEXIS publishers decide to include the New York Times in their database, the inclusion of the individual articles is no longer an original defining characteristic because NEXIS is merely trying to be as comprehensive as possible.<sup>126</sup> Therefore, NEXIS' selection of whole

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others as one work." *Tasini*, 533 U.S. at 500.

120. See text *infra* Part IV.A.1-3; Hicks, *supra* note 42, at 1006 (recognizing that subjective selection typically extends only to small compilations because of the selectivity that goes into "winnowing" a potentially large compilation down into a smaller one).

121. *Tasini*, 533 U.S. at 515 (Stevens, J. Dissenting), *citing* *Tasini v. New York Times, Co.*, 975 F. Supp. 804, 823 (1993) ("The New York Times perhaps even represents the paradigm, the epitome of a publication in which selection alone reflects sufficient originality to merit copyright protection.").

122. See Haemmerli, *supra* note 93, at 143 (arguing selection is not preserved in NEXIS because the user must take proactive steps to recreate an edition before it is in fact recognizable as the same selection); *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001) (comparing electronic magazine archive to original magazine); *Tasini*, 533 U.S. 483 (comparing third party electronic databases with print periodicals); *Ryan v. Carl Corp.*, 23 F. Supp. 2d 1146 (N.D. Cal. 1998) (applying § 201(c) revision privilege to copying of individual articles).

123. See Hicks, *supra* note 42, at 1025. Copyright for a compilation may be based on the author's subjective selection of preexisting material. *Id.* However, the contents of many databases may not reflect the necessary creative subjectivity because the data is amassed based on objective criteria that are not creative enough to reveal originality. See *id.* Most compilations are defined by their comprehensiveness and usually contain selections based on objective, not subjective criteria. *Id.* at 1006. However, even large compilations may reflect subjectivity in decisions made in their creation. *Id.* (arguing large compilations should be given equal protection under subjective selection doctrine as small compilations).

124. *Tasini*, 533 U.S. at 515 n.12 (Stevens, J., dissenting) (noting importance of New York Times selection process).

125. See Hicks, *supra* note 42, at 1025 ("Courts should scrutinize carefully the components of the databases, isolating those elements that reflect particular judgmental decisions by the database author from those elements that are purely objective and noncreative.").

126. See Hicks, *supra* note 42, at 1025 (arguing that because the nature of a database system

periodicals is not recognizable as the same selection the New York Times makes because NEXIS is not making any subjective selection of particular articles.<sup>127</sup> Conversely, the New York Times is not making any subjective selection of other periodical titles to include in the Times.<sup>128</sup> Therefore, the subjective selection that goes into NEXIS is not recognizable as the same subjective selection that goes into a particular edition of the New York Times.<sup>129</sup>

## 2. General Periodicals OnDisc CD-ROM (GPO)

As previously noted, the New York Times is defined by its subjective selection of individual articles for a particular day's paper.<sup>130</sup> GPO, on the other hand, is defined by its selection of general periodicals, including the New York Times' Sunday Book Review and Magazine.<sup>131</sup> Like NEXIS, once GPO makes the decision to include a periodical, it wants all of the articles in that periodical so that its

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makes the most comprehensive systems the most useful, the subjective selection doctrine will not give the database originality). *See also*, Feist Publ'ns, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991) (holding phone company did not make subjective selection by including all of its "subscribers" in its phone book). If including all of something is an objective selection, then NEXIS' inclusion of all of the New York Times articles is an objective selection. *See id.* Consequently, the New York Times' subjective selection is not preserved in the electronic database. *See id. Contra Tasini*, 533 U.S. at 509 (Stevens, J., dissenting) (arguing New York Times' selection is preserved by NEXIS database).

127. *See supra* note 126; *Feist*, 499 U.S. at 349; Sims, *supra* note 53, at 9. The New York Times' contracts with the electronic databases were licenses to publish the complete text of newspaper and magazine editions. Sims, *supra* note 53, at 9. The publishers delivered each edition's text to the databases as electronic files that would be uploaded into the database. *Id.* The database wanted the complete text and its contracts mirrored this desire. *Id.*

128. *See id.* The New York Times was fully aware that its periodicals were going to be included in a database that contained numerous other periodicals. *Id.* The Times' was primarily concerned with its contractual duty to send the text of the daily edition to the databases, and the databases' payment for such a license. *Id.*

129. *See supra* notes 120-28 (discussing importance of selection as a defining characteristic). Users reference particular works because of the publisher's subjective selection. *Cf.* Haemmerli, *supra* note 93, at 142-43 (noting perception of the user is important in determining recognizability of a work as a revision). A user searches NEXIS because of the numerous reputable *periodicals* the NEXIS publishers select to include in its database. *Id.* On the other hand, a user reads the New York Times for the *articles* that are selected by its renowned editors. *Id.* A user is drawn to NEXIS because of the periodicals it selects, and the user is drawn to the New York Times because of the articles it selects. *Id.* The respective publisher's selection is an integral part of how the work is perceived. *Id.* The 1976 Act includes perception as an important part of copyright protection. *Id.* at 143. This is seen in the Act's requirement that a work be "fixed" such that it can be perceived; and the defining of copyrightable subject matter as, "original works of authorship fixed in any tangible medium from which they can be perceived." *Id.*, citing 17 U.S.C. § 101 (defining fixation requirement); 17 U.S.C. § 102 (defining copyrightable subject matter).

130. *See supra* notes 120-29 (discussing importance of selection as a defining characteristic).

131. *Id.*

database will be comprehensive.<sup>132</sup> Users are drawn to GPO because of the diverse periodicals it selects to include in the database, but users read the New York Times for the articles selected.<sup>133</sup> The subjective selection made by GPO is not recognizable as the subjective selection made for a particular edition of the New York Times.<sup>134</sup>

### 3. New York Times OnDisc (NYTO)

NYTO's only subjective selection was picking its topic as the New York Times.<sup>135</sup> Once UMI decided to publish a CD-ROM of the New York Times, they did not subjectively select articles to include in its database; rather they merely wanted to compile every New York Times article to make their database comprehensive.<sup>136</sup> NYTO's subjective selection is not recognizable as the same subjective selection made for an issue of the New York Times.<sup>137</sup>

Consequently, even using subjective selection as an additional foothold for finding a subsequent work to be a revision, each of the three databases fail to be recognizable versions of the original New York Times.<sup>138</sup>

### B. Microfiche and Media Neutrality

The publishers attempted to analogize the electronic databases to microfilm or microfiche, a permissible adaptation of print periodicals.<sup>139</sup> NEXIS and GPO are easily distinguished from microfiche because the databases include material from numerous sources while microfiche is usually seen as an archive of a single periodical.<sup>140</sup> NYTO, on the other

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132. *Id.*

133. *Id.*

134. *Id.*

135. *See supra* notes 120-29 (discussing importance of selection as a defining characteristic).

136. *Id.*

137. *Id.*

138. *See* text and notes *supra* Part IV.A.1-3.

139. *See* *New York Times Co. v. Tasini*, 533 U.S. 483, 500 (2001). Microfiche is an acceptable use or modification of a work because the 1976 Act is intended to maintain media neutrality. Michael A. Forhan, *Tasini v. New York Times: The Write Stuff For Copyright Law?*, 27 CAP. U.L. REV. 863, 878 (1999). The legislative history of the 1976 Act shows that Congress wanted to extend copyright to new media. *Id.* An example of media neutrality in the 1976 Act is its "defining of 'copies' to include 'any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.'" *Id.*, *citing* 17 U.S.C. § 101 (defining "copies").

140. *See* Hur, *supra* note 35, at 87 n.218 (arguing NEXIS cannot be a revision because articles do not have to be retrieved with other articles from that particular edition). In fact, the New York Times actually forbids NEXIS from producing "facsimile reproductions of the particular editions."

hand, is more easily viewed as resembling microfiche because both contain past editions of a single periodical.<sup>141</sup>

The Supreme Court acknowledged that the Copyright Act embodies the concept of media neutrality; “that the transfer of a work between media does not alter the character of that work for copyright purposes.”<sup>142</sup> However, the Court rejected the microfiche analogy because “unlike the conversion of newsprint to microfilm, the transfer of articles to the Databases does not represent a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another.”<sup>143</sup> The Court went on to reject the publisher’s argument that these differences were necessitated by the medium.<sup>144</sup> However, in a world of emerging digital technology, the Court dismissed the concept of media neutrality too quickly.<sup>145</sup> A computer file containing the entire text of

*Id.* at 90 n.253, *citing* *Tasini v. New York Times, Co.* 206 F.3d 161, 169 (1999).

141. *See* *Hur, supra* note 35, at 87 n.219 (stating UMI database, NYTO, presents a more difficult issue than NEXIS because it only contains articles from one publisher). NYTO is “akin to an anthology of all editions of the New York Times.” *Id.* However, NYTO cannot be a revision because a new anthology would be a new collective work that exceeds the scope of the § 201(c) privilege. *Id.* The § 201(c) privilege is limited to “revisions” of “that collective work,” not entirely new collective works or anthologies. *Id.* *See also*, *Kia L. Freeman, Tasini v. New York Times: Wrong Issue, Wrong Presumption*, 32 *LOY. L.A. L. REV.* 841 (1999) (arguing the district court missed the issue in its decision by asking if the databases were substantially similar to the original collective work, while the proper issue was: in light of the original contributions of the author to the collective work, is the underlying work being used in a revision of that collective work or in an entirely different collective work; and concluding CD-ROMs are revisions, but NEXIS is not).

142. *Tasini*, 533 U.S. at 502. *See also*, *Deborah Tussey, The Creative Enemy of the True: The Meaning of Originality in the Matthew Bender Cases*, 5 *RICH. L.J. & TECH.* 10, at n.75 (1999) (“discussing how Congress intentionally drafted the definition of “copies” to avoid technology specific readings of the [copyright] statute and achieve media neutrality.”); *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 674 (2d Cir. 1998) (discussing media neutrality in context of online databases); *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 693 (2d Cir. 1998) (discussing media neutrality while denying copyright protection for pagination of West reporters); *Sims, supra* note 53, at 14 (“media-neutrality... seems to require that § 201(c) be construed either to allow publishers to make whatever is available on paper and in microfilm available in electronic media as well, or to compel them to halt and purge even the microfilm republication of their works.”).

143. *Tasini*, 533 U.S. at 502; *see also*, *Brief for Amici Curiae American Intell. Prop. Law Assoc.*, at 2001 WL 22982, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing, in support of neither party, that mere conversion of a collective work from one medium to another is a reproduction that is within the rights of a publisher under § 201(c) of the Copyright Act, however, such a conversion is not a permitted “revision” if each separate contribution is stripped from the collective work).

144. *Tasini*, 533 U.S. at 502; *see* *Michael A. Forhan, Tasini v. New York Times: The Write Stuff For Copyright Law?*, 27 *CAP. U.L. REV.* 863, 878 (1999). Publishers argued that the change in the medium is irrelevant because § 201(c) allows “revisions” without limitation to the nature or type of revision. *See* *Forhan, supra*, at 878.

145. *See Tasini*, 533 U.S. at 511-15 (Stevens, J., dissenting); *Sims, supra* note 53, at 14 (arguing media-neutrality is fundamental concept of 1976 Act which must be addressed in analysis of electronic publishing).

the February 22, 2002 New York Times would be large enough to create problems on underpowered computers, and long enough to make reader navigation nearly impossible.<sup>146</sup> Therefore, at some point it is reasonable for electronic publishers to break a larger collective work into sub-files for logistical reasons.<sup>147</sup>

Regardless, media neutrality does not justify a publisher's selling of articles individually, separate from the rest of the collective work.<sup>148</sup> The proper way to create an electronic "revision" of a work would be to place an entire pages worth of articles in one file, and provide links to "flip" to the next page or section of the collective work.<sup>149</sup>

### C. Transferability of §201(c) privilege

The Supreme Court did not address the transferability of the §201(c) privilege because it found that the electronic databases were not revisions of the freelance articles, and thus not part of the privilege in the first place.<sup>150</sup> However, as time passes, print works will continue to be archived in electronic databases, many of which, with the help of technological advances, will be deemed "revisions" under §201(c).<sup>151</sup> Therefore, it is important to note that the privilege accorded publishers in §201(c) is amenable to a nontransferable, non-exclusive license.<sup>152</sup>

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146. See *Tasini*, 533 U.S. at 511-15 (Stevens, J., dissenting) ("Just as a paper version of the New York Times is divided into sections and pages in order to facilitate the reader's navigation and manipulation of large batches of newsprint, so too the decision to subdivide the electronic version of that collective work into individual article files facilitates the reader's use of the electronic information."). *Id.* at 513 n.19 ("An ASCII version of the October 31, 2000, New York Times, which contains 287 articles, would fill over 500 printed pages.").

147. See *Sims*, *supra* note 53, at 14. It is hypocritical to allow publishers to offer complete photographic copies of their issues on microfilm, but not allow them to offer text only copies of the articles, which represent the bulk of the work, in electronic form. *Id.* Eventually, technology may allow documents to be presented electronically in a photographic format like microfilm but until then the medium necessitates the work be broken down into feasible units. *Id.*

148. See *Ryan v. Carl Corp.*, 23 F. Supp. 2d 1146 (N.D. Cal. 1998) (finding infringement of freelance author's copyright when defendant, with permission of collective publisher, copied and sold author's article separately from the collective work as a whole).

149. *Tasini*, 533 U.S. at 514 (Stevens, J., dissenting). The majority's focus on the GPO's inability to flip to the next page is nothing more than a criticism of the databases' medium-driven need to divide the periodicals into smaller units. *Id.*

150. *Tasini*, 533 U.S. at 494 (stating databases are not privileged revisions of the print periodicals, so "we find it unnecessary to determine whether the privilege is transferable").

151. See text *supra* Part IV.B. ("Microfiche and Media Neutrality"). Technological advances will likely allow electronic databases to be revisions in the future. *Id.*

152. See *Gordon*, *supra* note 48, at 477-48 (interpreting Copyright Act to say, absent a written agreement, or an employee/employer relationship, the publisher can only obtain a non-exclusive license to publish which is merely "permission" or a "right" to publish); Haemmerli, *supra* note 93, at 137-38 ("[G]iven the doctrinal history of copyright indivisibility and similar doctrine in the

Section 201 grants a freelance author complete ownership of his works, and absent evidence of an express transfer of rights, only grants publishers (collective authors) a limited “privilege” to publish the author’s work “as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.”<sup>153</sup> The term “privilege” is only used three times in the 1976 Act.<sup>154</sup> The canons of statutory construction teach that the same words used in the same statute should be given the same meaning.<sup>155</sup> In §109(d) and §111(d), “privilege” is used to refer to a non-exclusive license.<sup>156</sup> Consequently the “privilege” in §201(c) should be construed as a non-exclusive license.<sup>157</sup>

By definition, ownership of copyright is not “transferred” by a non-exclusive license.<sup>158</sup> Rather, a non-exclusive license merely gives the

adjacent patent field, as well as the revisions to the concept of copyright transfers that were occurring at the same time as the drafting of Section 201(c), it is more plausible to equate the privilege with a non-exclusive (and therefore non-transferable) license. . .”).

153. 17 U.S.C. § 201(c) (2002). *See* Gordon, *supra* note 48, at 491 (discussing transferability of § 201(c) privilege); Santelli, *supra* note 21, at 288 (interpreting § 201(c)’s privilege with respect to collective works, and concluding if only the first sentence was present, the authors would undoubtedly win; however, the second sentence gives the publishers certain privileges whose scope has yet to be determined).

154. *See* 17 U.S.C. § 201(c) (collective author is “presumed to have acquired only the privilege of reproducing and distributing the contribution. . .”); 17 U.S.C. § 109(d) (“privileges prescribed by subsections (a) and (c) do not, unless authorized by the copyright owner, extend to any person who has acquired possession of the copy or phonorecords”); 17 U.S.C. § 111(d) (referring to fee that must be paid for the “privilege” of re-transmitting conventional television broadcasts).

155. Geoffrey P Miller, *Pragmatics and the Maxims of Interpretation*, 1990 WIS. L. REV. 1179, 1183 (1990) (“The same words used in the same statute should be taken to have the same meanings.”).

156. Patrick J. O’Connor, *On-Line Computer Databases and CD-ROMS are Not the Electronic Equivalent of Microfilm: Tasini v. New York Times Co., Electronic Revisions, and Individual Contributions to Collective Works Under the Copyright Act of 1976*, 15 GA. ST. U.L. REV. 521, 544 (1998). *See* 17 U.S.C. § 109(d); 17 U.S.C. § 111(d).

157. *Compare* 17 U.S.C. § 201(c), *with* 17 U.S.C. § 109(d), *and* 17 U.S.C. § 111(d). *See* Haemmerli, *supra* note 93, at 135-38. The 1976 revision of the Copyright Act changed § 201(c) from a transfer of a “right” to a mere “privilege” to publish a contribution in a collective work. *Id.* at 136. Courts must decide whether this privilege is a proprietary interest, and thus transferable, or merely a permit to use the underlying work. *Id.* at 137. A “privilege” is defined as, “a particular and peculiar benefit or advantage. . . [which] exempts one from liability which he would otherwise be required to perform. . .” *Id.* at 137, *citing* BLACKS LAW DICTIONARY at 1197 (1990). The use of the term “privilege” in contradistinction to the “express transfer of proprietary rights” favors treating the privilege like a non-exclusive license without a proprietary interest. *Id.* Additionally, § 201(c), which was modified to counteract the doctrine of indivisibility, would not give away a proprietary right without the express assent of the author. *Id.* Therefore, it is most plausible to equate the § 201(c) privilege with a non-exclusive, non-transferable license. *Id.* at 138.

158. 17 U.S.C. § 101 (“A ‘transfer of copyright ownership’ is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect,

licensee permission to use the work.<sup>159</sup> Logically, the licensee cannot transfer a non-exclusive license because he does not technically own anything.<sup>160</sup> A tangible example of this principle is a friend you invite has permission to come to dinner, but he cannot transfer that privilege to a random third party.<sup>161</sup> Consequently, the publisher of a collective work cannot transfer his §201(c) privilege to a third party electronic publisher.<sup>162</sup>

In *Tasini*, the “transferability” issue renders the electronic databases infringements regardless of the Court’s decision on the “revision” issue.<sup>163</sup> The publishers and the courts are therefore destined to formulate a real world remedy for transferring electronic rights.<sup>164</sup>

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but not including a non-exclusive license.”)

159. See Haemmerli, *supra* note 93, at 137. The linguistic distinction between the § 201(c) “privilege” and a “right” is a indicator of the legislative intent to eliminate the doctrine of indivisibility, which had the effect of involuntarily transferring rights. *Id.* at 136. The legislative history shows § 201(c) was labeled a privilege because there should not be a presumption of transfer of ownership in the absence of an express transfer. *Id.* Rather Congress only intended to presume a “privilege” was given to the collective author. *Id.* If the privilege is a permit to use a work, and not a proprietary interest, then it is non-transferable. *Id.* at 137. However, if the privilege carried a proprietary interest, then it was transferable by the collective author. *Id.* In light of the legislative history discouraging the involuntary transfer of a proprietary interest, it is safe to assume the “privilege” is merely a permit to use the work. *Id.* Therefore, the § 201(c) “concept of a privilege is similar to that of a non-exclusive license, which provided permission to use a property free of liability, but does not convey an ownership interest in that property.” *Id.*

160. Josh J. May, *Intellectual Property Tasini v. New York Times Co.*, 16 Berkeley Tech. L. J. 13, 24 (2001) (“In copyright law, a non-exclusive license is non-transferable.”). Courts apply § 201(c) to give collective authors some minimal privileges in the absence of an express transfer of copyright, not to give them exclusive rights for which they did not bargain. *Id.* at 25. Compare Wendy J. Gordon, *Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 Brooklyn L. Rev. 473, 491 (2000). To hold the § 201(c) privilege completely inalienable would be overbroad because anytime a publishing company is sold, no § 201(c) privilege would adhere to the collective works sold with it. *Id.* If the § 201(c) privilege were completely not transferable, the buyer of an encyclopedia title could not reprint the encyclopedias because it would be infringing the underlying author’s reproduction rights. *Id.* at 492. The logical solution to these absurd results comes from interpreting “the owner of copyright in the collective work” as a status position, rather than an individual, so when copyright ownership of the collective work changes hands, the privilege changes hands as well. *Id.*

161. See Gordon, *supra* note 48, at 492. (“Some bare licenses are fully alienable (e.g. a typical movie ticket), but some are inalienable (e.g. the invitation from one friend to another to ‘drop in Tuesday night’)”).

162. See Haemmerli, *supra* note 93, at 138 (arguing doctrine and legislative history support treating § 201(c) privilege as a non-exclusive license). *Contra Tasini v. New York Times Co.*, 972 F. Supp. 804, (S.D.N.Y. 1997) (holding § 201(c) privilege a subdivision of a ‘right’ and thus transferable under § 201(d)), *citing* 17 U.S.C. § 201(d) (“Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately.”).

163. See text and notes *supra* Part IV.C. (arguing § 201(c) privilege is not transferable, and therefore electronic databases are infringements of authors’ copyrights); *Tasini*, 533 U.S. 483.

164. See *Id.* at 506 (remanding remedial issues to district court).

*D. Consequences and Solutions for the Future*

The Publishers persisted that a finding for the Authors would “punch gaping holes” in the electronic record of history when electronic publishers were required to delete unauthorized freelance articles from their databases.<sup>165</sup> However, the Supreme Court said “it hardly follows from today’s decision that an injunction against the inclusion of these Articles in the Databases (much less all freelance articles in any database) must issue.”<sup>166</sup> The Court continued by saying the parties “may enter into an agreement allowing continued electronic reproduction of the Author’s works; they (sic), and if necessary the courts and Congress, may draw on numerous models for distributing copyrighted works and remunerating authors for their distribution.”<sup>167</sup> The Court then remanded the remedial issues back to the district court for initial airing and decision.<sup>168</sup>

Omission of freelance articles from electronic collections, on any scale, would undermine the primary benefits that electronic databases provide researchers and the public.<sup>169</sup> However, Congress does not need to step in immediately to protect public access to freelance works

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165. *Id.* at 504 (majority dismissing publishers policy argument); *see also*, Brief of Amici Curiae Advance Publications, Inc. et al. at 2001 WL 22914, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing that removing freelance articles from internet would be devastating to the electronic record and impede public access to valuable information).

166. *Tasini*, 533 U.S. at 505, *citing* 17 USC § 502(a) (court “may” enjoin infringement); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578, n.10 (noting goals of copyright law are “not always best served by automatically granting injunctive relief”).

167. *Tasini*, 533 U.S. at 505; *see, e.g.*, 17 U.S.C. § 118(b); *Broadcast Music, Inc. v. Columbia Broad. System, Inc.*, 441 U.S. 1, 4-6, 10-12 (1979) (recounting history of blanket music licensing regimes and consent decrees governing their operation). The Court refused to let speculation about future harms shrink the author’s enumerated rights established by Congress in § 201(c). *Tasini*, 533 U.S. at 505-06. The Court was reluctant to establish a remedial scheme because “Congress can determine the nature and scope of the problem and fashion on (sic) appropriate licensing remedy far more easily than can courts.” *Id.* at 520 n.18, (Stevens, J., dissenting), *citing* 17 U.S.C. § 108(d)(1). After the author’s win in the Second Circuit, Plaintiff Tasini even urged publishers to negotiate licenses with freelance authors so as to avoid further litigation. Hur, *supra* note 35, at n.263.

168. *Tasini*, 533 U.S. at 506.

169. *See Tasini*, 533 U.S. at 520 (Stevens, J., dissenting). Electronic archives benefit researchers through efficiency, accuracy, and comprehensiveness. *Id.* Digital technology offers society unprecedented access to vast amounts of information in a searchable format. *See Atteritano, supra* note 5, at 378; Jane C. Ginsburg, *Putting Cars on the “Information Super Highway”*: *Authors, Exploiters, and Copyright in Cyberspace*, 95 COLUM. L. REV. 1466, 1467 (1995); Sheldon W. Halpern, *The Digital Threat to the Normative Role of Copyright Law*, 62 OHIO ST. L.J. 569, 571 (2001); Dixon, *supra* note 6, at 127; April M. Major, *Copyright Law Tackles Yet Another Challenge: The Electronic Frontier of the World Wide Web*, 24 RUTGERS COMPUTER & TECH. L.J. 75, 76 (1998); John D. Shuff & Gregory T. Holtz, *Copyright Tensions in a Digital Age*, 34 AKRON L. REV. 555, 557 (2001); David J. Loundy, *Revision the Copyright Law for Electronic Publishing*, 14 J. MARSHALL J. COMPUTER & INFO. L. 1, 4 (1995).

because there are alternative, less intrusive solutions to achieve copyright's goals.<sup>170</sup> Now that the Court has clarified who owns electronic rights, the parties can individually contract for these rights, or establish Collective Rights Organizations (CRO).<sup>171</sup> If neither of these less intrusive options is successful in furthering copyright's primary goal of promoting the public welfare, then Congress should step in and establish a compulsory licensing system.<sup>172</sup> This Note now examines

170. Freeman, *supra* note 141, at 875 (discussing appropriate way for copyright law to deal with novel issues). In the early days of a new issue, it is inappropriate to pass new legislation. *Id.* The proper way to discover the boundaries of new rights is through trial and error. *Id.* First, interested parties use whatever devices or techniques are available to them, including contractual arrangements, to stake a claim on the new unregulated right. *Id.* Then, after interested parties make the first moves, the law can step in and recognize an official method of control over the new right. *Id.*, citing Ejan MacKaay, *The Economics of Emergent Property Rights on the Internet*, in *THE FUTURE OF COPYRIGHT IN A DIGITAL ENVIRONMENT* 13, 19-21 (P. Bernt Hugenholtz ed. 1996). See also, Atteritano, *supra* note 5, at 405-409 (arguing for the use of contract and collective societies to solve digital dilemma). Contracting is the "ultimate solution" to the controversy if both sides are willing to enter into meaningful negotiation and compromise. *Id.* at 405. The "future solution" is utilization of "copyright clearing centers," which will assist in easing the parties' concerns about straight contracting. *Id.* at 406. The United Kingdom is a real world example where these less intrusive solutions proved to be a "thriving industry for the marketing of copyrighted works." Forhan, *supra* note 144, at 882.

171. See Forhan, *supra* note 144, at 882. Collective rights organizations act as middlemen or brokers of the copyrighted material. *Id.* The CRO's compile individual works and sell licenses to customers, which permit them to use the work in exchange for a fee. *Id.* This simplifies the licensing process while allowing authors to retain a more powerful voice in the control and dissemination of their works. *Id.* The National Writer's Union established the Publication Rights Clearinghouse (PRC) to administer collective licensing of freelance work, and digitally process permission payments. See Hur, *supra* note 35, at 91 n.267. The PRC licenses to publishers and databases non-exclusive rights to its inventory of articles and books. *Id.* The PRC enrolls authors who own the secondary rights to their works and places their works into the PRC inventory. *Id.* The entire PRC repertoire is then licensed to publishers, who collect and pay PRC fees for the use of the PRC author's works. *Id.* PRC then distributes this money to its member authors for the use of their works. *Id.* See also, *Publication Rights Clearinghouse of the National Writers Union*, available at <http://www.nwu.org/prc/prchome.htm> (last visited Feb. 20, 2002) (giving details about Publication Rights Clearinghouse). An alternative organization is the Author's Registry, established by the Author's Guild and The American Society of Journalists and Authors. Jason Williams, *Court Decision for Freelancers Could Leave Gaps in Archives*, EDITOR & PUBLISHER, Oct. 2, 1999, at 5. The Author's Registry locates authors for publishers and will accept, and hold in trust, secondary use fees from publishers who want to use an author's work but is having difficulty finding the author. *Id.* The Author's Registry does not license the author's works. *Id.*

172. See, e.g., 17 U.S.C. §§ 114-122 (establishing a compulsory licensing system for distribution and public performance of musical works). Congress could alternatively step in and amend the 1976 Act to clarify the issue of electronic rights. Smith, *supra* note 42, at 1124. As seen in past federal copyright statutes, Congress has acted similarly in the past to resolve inconsistencies in copyright law. *Id.* at 1127. "[F]rom its beginning, the law of copyright has developed in response to significant changes in technology. . . [and] it has been Congress that has fashioned the new rules that new technology made necessary." *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984); see also, Michael A. Forhan, *Tasini v. New York Times: The Write Stuff for Copyright Law?*, 27 CAP. U.L. REV. 863, 865-67 (giving brief history of copyright law).

contracts, CRO's, and compulsory licensing to see the benefits and drawbacks of using each method to transfer electronic rights.<sup>173</sup>

### 1. Contracts, Licenses, and New-Use Analysis

The holding in *Tasini* leaves the parties free to modify their rights through contract.<sup>174</sup> Publishers and authors are free to integrate electronic rights into their future contracts and licenses.<sup>175</sup> In fact, many of the parties already began requiring freelancers to explicitly surrender the electronic rights to their submissions and some, like the New York Times, even require contributors to waive their rights retroactively as a condition for future publication.<sup>176</sup> Every publisher will want to include such a grant of electronic rights in future contracts with freelance authors because in order for a grant of electronic rights to be effective, the contract or license must be clear, "in writing, and signed by the owner of the rights conveyed."<sup>177</sup>

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173. See text *infra* Part IV.D.1.-3.

174. See Sara Sadler Nelson, *Practical Impact of Supreme Court Ruling on Author/Publisher Digital Use Concerns*, ENT. L. AND FINANCE, Jul. 2001, at 1 (2001) (recognizing publishers can contractually alter the holding in *Tasini*). However, the difficulty with contracting around the holding is retroactive licensing of works already in the databases because publishers would have to expend substantial resources to track down authors and negotiate licenses with them. Hur, *supra* note 35, at 92 n.272; see Dixon, *supra* note 6, at 149 n.81 (noting freelance authors and publishers have historically created oral, ambiguous contracts that did not address electronic rights); Hur, *supra* note 35, at n.117 (describing contracts between authors and publishers).

175. See Robert P. Merges, *Contracting Into Liability Rules: Intellectual Property Rights and Collective Rights Organizations*, 84 CALIF. L. REV. 1293 (1996); Nelson, *supra* note 174, at 1; Joanne Benoit Nakos, *An Analysis of the Effect of New Technology on the Rights Conveyed by Copyright License Agreements*, 25 CUMB. L. REV. 433, 446 (1995).

176. See Hur, *supra* note 35, at 65. The decision against the publishers resulted in contracts allowing electronic publication of the author's works without additional compensation for these rights. *Id.* "Some publishers negotiate additional fees with big-name authors. Some publishers will not sign a contract without electronic rights." *Id.* at 68 n.29. "All-rights" contracts are the norm with many publishers. *Id.* A freelancer who wants to publish repeatedly with the New York Times must give the company the privilege to include their article in electronic databases, and must agree to do so for every article that he ever published with the New York Times. Nelson, *supra* note 174, at 1.

177. See Atteritano, *supra* note 5, at 404. Publishers have begun formalizing their contracts with freelancers since the *Tasini* case was filed in 1993. *Id.* Publishers have also made sure these new written contracts adequately addressed electronic rights. *Id.* Publishers have dual motives for demanding electronic rights in their new contracts: to prevent future litigation, and to get revenue from the electronic exploitation of their collective works. *Id.* See 17 U.S.C. § 204(a) ("A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent."). If the grant is an exclusive license or assignment, it must be a clear expression of the intent of the parties to convey a copyright interest, in writing, and signed. See Nelson, *supra* note 119. The author may utilize a non-exclusive license to grant the publisher permission to use the work digitally, while the author retains all of his

Contract problems arise when new technologies emerge that were not explicitly contemplated by the contracting parties.<sup>178</sup> Absent a complete transfer of rights to a work, the contracting parties are left unsure about who owns the rights to exploit the new use.<sup>179</sup> Two schools of thought have emerged in doing this “New-Use” analysis: the *Bartsch* (preferred) approach, and the *Cohen* (strict) approach.<sup>180</sup>

The *Bartsch* court adopted a broad approach that allows a licensee to pursue any uses that can reasonably be said to fall within the medium described in the license, including the “ambiguous penumbra” of the terms.<sup>181</sup> This approach is “preferred” because it encourages the development of new media, thus benefiting society through access to protected works.<sup>182</sup>

The *Cohen* Court adopted a narrower approach that refused to give licensees the rights to new media that were unforeseeable at the time of

exclusive rights to the work. *Id.* *But see*, Smith, *supra* note 42, at 1107 (pointing out that defendant publishers often used oral contracts with little or no discussion over rights in the articles).

178. *See* *Bartsch v. Metro-Goldwyn-Mayer*, 391 F.2d 150 (2d Cir. 1968); *Rey v. Lafferty*, 990 F.2d 1379 (1st Cir. 1993); *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851 (9th Cir. 1988); *SAPC, Inc. v. Lotus Dev. Corp.*, 921 F.2d 360 (1st Cir. 1990); *Brown v. Twentieth Century Fox Film Corp.*, 799 F. Supp. 166 (D.C. 1992); *Landon v. Twentieth Century Fox Film Corp.*, 384 F. Supp. 450 (S.D.N.Y. 1974); *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481 (3d Cir. (1956)); *Kirke La Shelle Co. v. Paul Armstrong Co.*, 188 N.E. 163 (N.Y. 1933).

179. *See supra* note 181; *Dixon, supra* note 6, at 150 n.85 (discussing effect of new technology on intellectual property contracts). The 1976 Act does not clearly define the rights of freelance authors in their works. *Forhan, supra* note 144, at 864. “This leaves the rights of the authors to be determined by the terms of their contracts with the publisher (if indeed such a contract exists), or by judicial interpretation of the extent of the publishers’ rights.” *Id.*

180. *See* Sidney A. Rosenzweig, *Don’t Put My Article Online!: Extending Copyright’s New-Use Doctrine to the Electronic Publishing Media and Beyond*, 143 U. PA. L. REV. 899, 916-20 (1995), *citing Bartsch*, 391 F.2d at 150, and *Cohen*, 845 F.2d at 851. The *Bartsch* approach was coined the “preferred” approach by professor Nimmer. 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §10.10B, at 10-87 to 10-89 (1994) (discussing § 201(c) with respect to licensing). The *Cohen* approach was referred to as the “strict” approach because of its strict adherence to underlying contract principles. *Id.* *See also*, *Nakos, supra* note 175, at 446 (discussing *Rey v. Lafferty*, 990 F.2d 1379 (1st Cir. 1993), which utilized the *Cohen* approach); *Atteritano, supra* note 5, at 388 (applying preferred and strict approaches to electronic publishing).

181. *Bartsch*, 391 F.2d at 155; *see Rosenzweig, supra* note 180, at 916; *Nakos, supra* note 175 at 444; *Atteritano, supra* note 5, at 388.

182. *See Rosenzweig, supra* note 180, at 918. “Because new media are designed to improve the quality or facilitate the flow of information in society, efforts to encourage their development are in the public interest.” *Id.* *See also*, *Sony Corp. v. Universal City Studios, Inc.* 464 U.S. 417, 429 (1984) (acknowledging the benefits of free flow of ideas, information and commerce); Information Infrastructure Task Force, U.S. Dept. of Commerce, Preliminary Draft of the Report of the Working Group on Intellectual Property Rights § IV(5) (July 1994) (“The Copyright Act exists for the benefit of the public. To fulfill its constitutional purpose, the law should strive to make the information contained in protected works of authorship freely available.”).

contracting.<sup>183</sup> The court reasoned that it is not fair to hold that the grantor impliedly gave up his rights when the “medium was ‘completely unforeseeable and therefore could not possibly have formed part of the bargain between the parties at the time of the original grant.’”<sup>184</sup>

Neither approach is without flaw, so parties continuously argue that the theory adopted by a particular court puts one party in an unfair position, or it defeats the underlying goals of copyright law.<sup>185</sup> The solution for parties negotiating contracts and licenses is a future technologies clause that addresses “rights in the work now existing, or which may hereafter come into existence.”<sup>186</sup> Inclusion of a future technologies clause eliminates most of the new-use confusion and can be dispositive evidence of who owns the future rights to a work.<sup>187</sup> However, many authors are hesitant to accept these future technologies clauses that grant “all rights” to the publisher because they feel forced into negotiating away rights that have a currently undetermined market value.<sup>188</sup> However, this inherent risk in the transaction is no different

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183. *Cohen*, 845 F.2d at 851; see Rosenzweig, *supra* note 180, at 919; Nakos, *supra* note 175, at 446-47.

184. Rosenzweig, *supra* note 180, at 919, citing *Rey v. Lafferty*, 990 F.2d 1379, 1388 (1st. Cir. 1993); see also, *Cohen*, 845 F.2d at 854 (reasoning licensee could not have bargained for rights of videocassette reproduction before the invention of the videocassette recorder); *Kirke La Shelle Co. v. Paul Armstrong Co.*, 188 N.E. 163, 15-66 (N.Y. 1933) (holding rights to make movie with sound were not part of agreement because technology to make motion pictures with sound was not yet invented at the time of contract).

185. Nakos, *supra* note 175, at 448 (discussing inherent flaws in both the *Bartsch* and *Cohen* approaches to New-use analysis); see also, Rosenzweig, *supra* note 180, at 920 (examining *Bartsch* and *Cohen*).

186. Carolina Saez, *Enforcing Copyrights in the Age of Multimedia*, 21 RUTGERS COMPUTER & TECH. L.J. 351, 366 (1995). The “now known or hereafter” clause has many adaptations such as “Author licenses the right to publish this article in all technologies now known or hereafter created”; or “Author reserves right to publish work in technologies not now known or that hereafter come into existence.” See *id.*

187. See Saez, *supra* note 186, at 366 (noting tremendous impact future technology clauses have had in U.S. litigation); *Cohen*, 845 F.2d at 855. But see, Saez, *supra* note 186, at n.113 (“over-reliance on these clauses should certainly be avoided in the multimedia world of global markets and a border-less information superhighway. It is entirely possible that these clauses *may* actually be unenforceable outside the United States, thus resulting in uneven enforcement of the clause to the detriment of all those involved in the multimedia venture.”).

188. Saez, *supra* note 186, at 366; see Dixon, *supra* note 6, at 130 n.12 (acknowledging print publications such as newspaper may unwittingly force freelance authors into unfavorable contracts); Sims, *supra* note 53, at 15 (“publishers have already begun demanding express written transfers of online rights from their freelance contributors without marginal increases in payments offered, and obtaining agreement to those terms. Such demands will only become more prevalent.”). If a freelance author will not sign the form contract that grants electronic rights to the publisher, the paper will simply commission the needed articles from another author “clamoring for publication.” Sims, *supra* note 53, at 14. Publications have used a “take it or leave it” approach when negotiating these contracts. *Id.*; Atteritano, *supra* note 5, at 405. Contracts that specifically grant the publisher

than the calculated risk an author assumes when he decides to sell his work outright.<sup>189</sup> Additionally, “both parties may benefit if the future technology clause has been coupled with a provision specifying that the artist is to receive an ongoing percentage of the revenue stream regardless of the media utilized.”<sup>190</sup>

The problem with individualized contracts and licenses is that they create the impossible task, which the New York Times faces, of hunting down thousands of past freelance authors and the immense administrative expense associated with individually negotiating licenses with each of them.<sup>191</sup> Recognizing this burden, many publishers have opted to begin mass deletions of freelance articles from the electronic databases.<sup>192</sup> As previously mentioned, the destruction of these databases defeats the efficiency, accuracy and comprehensiveness that electronic databases offer researchers and the public.<sup>193</sup> Allowing publishers to delete freelance articles will inevitably reduce the public’s access to these works, which is contrary to copyright law’s goal of promoting the public welfare.<sup>194</sup> Accordingly, the parties and the courts

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“all rights” in a work upset the “symbiotic relationship” between authors and publishers. Shuff, *supra* note 8, at 566. Authors and Publishers need each other. *Id.* They have historically participated in a give-and-take that efficiently distributes works and fairly compensates authors, but that balance is upset when publishers suddenly demand “all rights” from the authors. *Id.* The authors are suddenly disenfranchised with respect to the dissemination of their works. *Id.*

189. See Saez, *supra* note 186, at 366.

190. *Id.* See Santelli, *supra* note 21, at 281-282 (arguing that payment contracts are the best solution because they maintain an incentive to authors by giving them continued income from their works while giving publishers the right to disseminate the works to the public); Smith, *supra* note 42, at 1122 (“Other publishers, such as Publishers Weekly and the Nation, have followed Harper’s lead on sharing royalties with freelancers, while other magazines routinely pay a separate fee for electronic publishing.”)

191. Jeffery P. Weingart & Jill Westmoreland, *Tasini Case May Set Back Freelancers, Publishers: To Avoid Expense, Publishers May Remove Existing Works From Online Publications*, NAT’L L.J., Oct. 25, 1999, at C3. See May, *supra* note 160, at 26; Meitus, *supra* note 10, at 772-73.

192. See Sims, *supra* note 53, at 15. Publishers are businessmen who will do a cost benefit analysis and follow the cheaper route regardless of the harm to the public’s access to works. *Id.* Publishers prefer deleting the articles rather than “(a) spend the resources necessary to locate freelance writers of articles written over the past few decades, and (b) spend the resources necessary to come to acceptable terms with them.” *Id.*; Tony Mauro, *New York Times’ Response to Tasini Ruling is Inappropriate, Author’s Guild Charges*, INTELL. PROP. STRATEGIST, Jul. 2001, at 9 (2001) (“Within minutes of the decision, New York Times Chairman and Publisher Arthur Sulzberg Jr. said the company would begin ‘the difficult and sad process of removing significant portions from its electronic historical archive.’”).

193. See *New York Times Co. v. Tasini*, 533 U.S. 483, 520 (2001) (Stevens, J., dissenting); Brief of Amici Curiae Ken Burns, *et al.* at 2001 WL 23641, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing that a finding in favor of authors will both threaten the completeness of the electronic archives and decrease access to convenient and cost efficient means of comprehensive research).

194. May, *supra* note 160, at 26 (“... court... worr[ie]d that not allowing publishers to

are searching for more efficient models of licensing works for electronic use.<sup>195</sup>

## 2. Collective Rights Organizations

Collective Rights Organizations (CRO) alleviate the administrative inefficiency of individually contracting with numerous authors for secondary rights.<sup>196</sup> Writers assign the CRO the right to act as their agent, and the CRO then offers publishers the non-exclusive right to use the work for a fee.<sup>197</sup> Once the CRO has collected the fee, it distributes royalties to the author.<sup>198</sup> A CRO can efficiently allocate royalties to freelance writers while keeping the electronic databases intact.<sup>199</sup>

The problem with CRO's is getting both sides to participate in the

electronically distribute writers' copyrighted articles would undermine the policy goal of 'ensuring that collective works be marketed and distributed to the public.'"). Not only will the public be injured by the removal of works from the databases, but the public will also suffer injury when online material decreases in quality. Atteritano, *supra* note 5, at 405. As publishers utilize "take it or leave it" contracts, inevitably some authors will "leave it" and the publishers will hire substituted authors to fill in the void. *Id.* Consequently, the public will lose access to some talented authors, and have to endure less talented writers with a "lower quality of work product." *Id.*

195. *See Tasini*, 533 U.S. at 506 (remanding remedial issues back to the District Court for the Southern District of New York); Haemmerli, *supra* note 93, at 148 ("Most authors want their works to be distributed, and would willingly agree to license their electronic publication. They simply want to be compensated for that publication."); Mauro, *supra* note 192, at 9 ("The Supreme Court didn't say the Times had to remove the articles, it said it had to pay for them . . . The Court stressed that these issues could be resolved through licensing systems, such as that operated by the Author's Registry.").

196. May, *supra* note 160, at 26-27 ("Commercial copyright transactions require negotiation, monitoring, and enforcement that can be prohibitively costly for individuals but feasible for a CRO. CRO's, which flourish in the presence of new forms of media, devise general rules that replicate contracting terms between two parties and substantially lower transaction costs.").

197. Merges, *supra* note 175, at 1295. Collective agencies automatically emerge to break a transactional bottleneck in an industry. *Id.*

198. *See id.*; May, *supra* note 160, at 28. Publication Rights Clearinghouse members typically get from seventy-five percent to ninety percent of the fees paid to the CRO. *Id.*

199. Merges, *supra* note 175, at 1295-96. CRO's have two distinct advantages over compulsory licensing by the state. *Id.* at 1295. First, CRO's provide "expert tailoring" whereby knowledgeable industry participants set the rules of exchange. *Id.* Compulsory licenses, on the other hand, are uniform and limited in scope by the statute. *Id.* A CRO's ability to tailor its contracts provides an "intermediate level of contract detail, reflecting not only collective industry expertise but also the need for efficiency in carrying out a high volume of transactions." *Id.* at 1296. The CRO's allows the contracts to be both flexible and efficient. *Id.* A CRO's second advantage is the ability to be flexible itself, unlike a set in stone statutory compulsory licensing scheme. *Id.* If rates need to be adjusted, a CRO can easily make the needed changes. *Id.* On the other hand, a compulsory licensing system is subject to "legislative lock-in" where Congress is slow to react to needed changes, and interested parties can influence Congress not to make the changes. *Id.* at 1296. Last, CRO's allow individual rights holders, rather than the state, to set the standard terms of the licensing agreements. *Id.* at 1297.

licensing scheme.<sup>200</sup> First, a CRO must get authors to enroll, which is becoming easier as freelance authors “realize that without joint action no compensation would be forthcoming at all.”<sup>201</sup> Second, and perhaps more difficult, is getting publishers to work with CRO’s.<sup>202</sup> As noted earlier, publishers are free to condition initial publication on an express transfer of electronic rights, thus negating a need to pay a fee to a CRO for secondary rights.<sup>203</sup>

Although some publishers have resorted to these guerilla tactics, other publishers have conceded to the author’s rights, and have begun bargaining with the Publication Rights Clearinghouse (PRC) a new CRO aimed at marketing freelance works of authorship.<sup>204</sup> Hopefully the ruling in *Tasini* will encourage more and more authors to join the PRC, leaving publishers no choice but to deal with the PRC to get content for their collective works.<sup>205</sup>

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200. May, *supra* note 160, at 28. “In order to succeed, the PRC must enroll as many freelance writers as possible and persuade publishers and databases to comply with its licensing scheme.” *Id.* The PRC has signed a deal with Contentville, a large online database, but the PRC, or other CRO’s must get widespread acceptance before it truly becomes effective. *See id.*

201. *See Merges, supra* note 175, at 1293 (arguing that Collective Rights Organizations are the solution to the conflict between copyright and new technologies).

202. May, *supra* note 160, at 28. “While these royalty-distributing organizations may provide part of the solution to using copyright effectively in forwarding the interests of authors, publishers, and users, they will not accomplish this goal unless authors retain the electronic rights to their works.” Atteritano, *supra* note 5, at 408. If the authors sign their rights over to the publishers, the publishers will have no incentive to negotiate or work with a CRO because they already own the electronic rights. *Id.* Authors are advised to contract for electronic rights compensation, or to retain their electronic rights despite the “all-rights grab” by the publishers. *Id.* If the authors stick together, copyright protection itself will “serve to help balance the unequal bargaining positions of the publisher and the freelance author.” Ryan J. Swingle, Note: *Tasini v. New York Times: The Problem of Unauthorized Secondary Usage of an Author’s Works*, 5 J. INTELL. PROP. L. 601, 621 (1998).

203. Freeman, *supra* note 141, at 876 (commenting that modern publishers routinely require express transfers of copyright from freelance authors). Many commentators think freelance authors will be forced to give up their electronic rights because of the publisher’s dominant negotiating position. *See, e.g.,* Dixon, *supra* note 6, at 154-55; Hoff, *supra* note 50, at 165; Meitus, *supra* note 10, at 752; Forhan, *supra* note 144, at 863 (comparing the current U.S. approach to that of Great Britain; and concluding the issue will likely be solved by the industry through contracts, rather than by Congress or the courts, and authors will likely bargain away their rights in order to get published).

204. *See* Sims, *supra* note 53, at 13-14. Some “publishers have begun requiring writers to transfer electronic rights in the signed writings as a condition to first publication, and databases are seeking to obtain similar express transfers.” *See supra* note 203.

205. *See* Meitus, *supra* note 10, at 775-76. As a result of the Supreme Court’s pro-author holding, most authors will undoubtedly affiliate with the PRC or a similar organization. *Id.* The PRC has already paid out thousands of dollars in royalty payments to its member authors. *Id.* The Court’s holding gives freelance authors greater leverage in getting publishers to abide by the PRC’s licensing scheme, under the author’s terms. *Id.* *See also*, May, *supra* note 160, at 28 (discussing merits of authors using Collective Rights Organizations).

### 3. Compulsory Licensing

If authors and publishers do not embrace the PRC, and if the inefficiencies of individual contracting encumber the development of electronic media, Congress may step in and enact a compulsory licensing scheme.<sup>206</sup> Compulsory licensing statutorily requires a copyright owner to grant a license at an established rate.<sup>207</sup> As a result, publishers can use any work they want in their collective database so long as they are willing to pay the statutory fee.<sup>208</sup> On the other side, authors are guaranteed at least some compensation for the use of their work.<sup>209</sup>

At first glance, compulsory licensing seems to be a viable solution for the transfer of electronic rights, but it is subject to many criticisms.<sup>210</sup> First, there is no clear way to devise a fair pricing schedule for literary works.<sup>211</sup> Second, authors inherently lose control over reproduction and

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206. See 17 U.S.C. § 114 (setting forth compulsory licensing scheme for the music industry); Naomi Abe Voegtli, *Rethinking Derivative Rights*, 63 BROOKLYN L. REV. 1213, 1265 (1997); Merges, *supra* note 175, at 1295.

207. Corey Field, *New Uses and New Percentages: Music Contracts, Royalties, and Distribution Models in the Digital Millennium*, 7 UCLA ENT. L. REV. 289, 295 (2000). Compulsory licensing is legislation with a statutory mandate that the rights be licensed to all comers willing to pay the pre-set price. Merges, *supra* note 175, at 1295. Legislatively mandated licensing reduces transaction costs in two ways. *Id.* First, contract terms are predetermined thus reducing and even eliminating haggling. *Id.* Second, compulsory licensing may have built in administrative support that saves parties the cost of record keeping, payment collection, and royalty disbursement. *Id.*

208. See Voegtli, *supra* note 206, at 1264. Collective authors face two main obstacles when trying to get permission to use an underlying work. *Id.* First, the collective author must get the original author's permission to use the work. *Id.* Second, the collective author must have sufficient resources and money to contact the other author, negotiate with the other author, and pay money to the other author for a license. *Id.* Compulsory licensing gets rid of the permission obstacle by statutory mandate, and alleviates the money problem because reducing the transactional costs associated with negotiating a license. *Id.*

209. See Merges, *supra* note 175, at 1295. Although the rights must be licensed to a publisher, the publisher must pay the pre-set rate. *Id.* Then the organization or system pays the authors royalties for the use of their works. *Id.*

210. See *infra* text. Compulsory licenses appear to be a compromise that reduces the transactional costs of licensing intellectual property rights, while preserving most of the economic advantages that accompany stronger rights. Merges, *supra* note 175, at 1293. However, rather than institute a slow government run licensing system, experience in other industries has shown that participants will establish more efficient private collective rights organizations. *Id.* at 1295. Current evidence is already showing that this is happening with the establishment of the Author's Registry and the Publication Rights Clearinghouse. See *id.*

211. Voegtli, *supra* note 206, at 1264. A statutory fee based on the amount of data taken, priced out per "bit", seems fair for an information database because the amount taken directly correlates to the value of the appropriated information. *Id.* However, the volume or amount taken does not accurately represent the value of literary and artistic works. *Id.* Some of the world's most valuable literary works, Keats' Ode on a Grecian Urn for example, are worth substantially more

distribution, both exclusive rights under the Copyright Act.<sup>212</sup> Third, a compulsory licensing scheme for electronic rights would require an effective method of monitoring file transfers.<sup>213</sup> This file monitoring system, combined with an effective pay-per-use system, could be used to charge the public for simply browsing Internet websites.<sup>214</sup> Lastly, compulsory licensing may decrease the scope of “fair use” on the Internet by creating an identifiable market for a copyrighted work, therefore turning the last fair use factor against someone previously making a fair use of a copyrighted work.<sup>215</sup>

Although each of the models set forth contain flaws, the system the parties adopt will inevitably be calculated to promote the public welfare because the parties adequately represent the competing goals of copyright law.<sup>216</sup> The publishers strenuously advocate expanding their

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than a horribly written 700-page novel by an unknown author. *See id.*

212. *See Saez, supra* note 186, at 351. A compulsory licensing scheme would be enacted as an amendment to the Copyright Act, thus making an exception to the author’s exclusive rights. *See, e.g.*, 17 U.S.C. § 114(a) (“The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3), and (6) of section 106, and do not include any right of performance under section 106(4)”). However, “if every time we can no longer enforce the exclusive nature of a right. . . if every time we react by creating a remuneration right only, we are gradually pushing copyright away from its nature as a fundamental right into a type of taxation system. . . [and] if this continues without reaction, copyright will be dead in 30 years.” *Saez, supra* note 186, *citing* Janet Ibbotson & Nainah Shah, *Interactive Multimedia and Electronic Publishing*, COPYRIGHT WORLD, Oct. 1993, at 32.

213. Voegtli, *supra* note 206, at 1265. Computers are well suited for tracking a work’s use. Shuff, *supra* note 8, at 569. Copy protection mechanisms, like those for digital music, could be imbedded in electronic works to thwart unlawful copying, or to track use. *Id.* After the work had been used, a system could solicit an appropriate fee from the user and compensate the author. *Id.* Clearinghouse of individual works may be created that includes terms for secondary distribution of a work as well as automatic billing and collection of licensing fees to be paid to the author. *Id.*

214. Voegtli, *supra* note 206, at 1265.

215. *Id.*, *citing* American Geophysical Union v. Texaco, Inc., 60 F.3d 913 (2d Cir. 1994) (holding copying of professional journals was not fair use in light of ready market created by Copyright Clearance Center for remunerating copyright owners for photocopies of their works). *See* 17 U.S.C. § 107 (listing four factors that determine fair use as: “(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the market for or value of the copyrighted work.”).

216. *See* Dixon, *supra* note 6, at 144 n.54 (stating copyright law balances an incentive for the creation of works with ensuring the public and later creators can enjoy and build on those works); *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (demonstrating publishers and authors fighting for electronic rights). The balance of author against publisher is analogous to copyright’s balance of promoting creation through incentives, and promoting free access to copyrighted works. Ryan J. Swingle, Note: *Tasini v. New York Times: The Problem of Unauthorized Secondary Usage of an Author’s Works*, 5 J. INTELL. PROP. L. 601, 612-13 (1998). Having competing viewpoints protects society against “two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward

rights to give the public more access to copyrighted works.<sup>217</sup> The authors strenuously advocate expanding their rights to establish incentives to create new works.<sup>218</sup>

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of their ingenuity and labour; the other, that the world may not be deprived of the improvements, nor the progress of the arts be retarded." *Id.*, citing *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

217. Brief for Petitioners at 2001 WL 27573, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing Congress intended publishers to be able to make their publications and "any revisions" available to the public; electronic copies are privileged under § 201(c) because legislative history confirms the breadth of the clause; and reading § 201(c) so as to prevent electronic publication conflicts with the basic tenets of copyright law, to promote general welfare through dissemination); Reply Brief for Petitioners at 2001 WL 267401, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing electronic copies are revisions of their collective works because they publish the entire editorial content of the original work; therefore the media neutral Copyright laws should allow the transfer of works to digital form under the same license); *see also*, Brief of Amici Curiae Advance Publications, Inc. et al. at 2001 WL 22914, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing removal of freelance articles from internet would be devastating to the electronic record and impede public access to valuable information); Brief of Amici Curiae Ken Burns et al. at 2001 WL 23641, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing that a finding in favor of authors will both threaten the completeness of the electronic archives and decrease access to convenient and cost efficient means of comprehensive research; that the focus on end users in determining whether electronic archives qualify as "revisions" under § 201(c) is inconsistent with the practical realities inherent in the process of research, as well as the longstanding publishing industry assumptions regarding the permissibility of traditional analog means of periodical, newspaper, or journal storage and retrieval); Brief of Amicus Curiae the National Geographic Society at 2001 WL 27568, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing publisher of printed collective work is entitled to reproduce and distribute that collective work in any medium (or combination of media) it chooses); Brief of Amici Curiae Software & Information Industry Association et al. at 2001 WL 27570, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing legislative history does not support Second Circuits interpretation of § 201(c), and differences between the databases and the original print publications are immaterial as a matter of law because of media neutrality, because the differences are no different than a printed revision, and because selection of articles is protected independently from arrangement; arguing it is immaterial how a third party can search through the materials because this is direct infringement case).

218. Respondent's Brief at 2001 WL 174956, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing § 201(c)'s plain meaning confines scope of publisher's privilege to revisions in the same series, not new collective works; that the legislative history supports this plain meaning; and that narrowly reading § 201(c) to not allow electronic publishing of freelance articles in databases is consistent with precedent and copyright policy); Brief for Respondents Tasini, Blakely, Mifflin & Whitford at 2001 WL 177049, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing that § 201(c)'s language and legislative history justify a finding that newspaper publisher's electronic publishing of freelance articles exceeds the scope of the § 201(c) privilege); *see also*, Brief of Amici Curiae American Library Assoc. & Assoc. of Research Libraries at 2001 WL 173550, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing Copyright Act does not require deletion of works from electronic databases and/or destruction of CD-ROMs; rather the courts can require payment of fair compensation to authors in the form of past and continuing royalties while maintaining public access); Brief of Amici Curiae American Society of Media Photographers, Inc. et al. at 2001 WL 177046, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing legislative history of § 201(c) shows it was intended to protect authors' copyrights in contributions to collective works and to grant publishers

## V. CONCLUSION

*Tasini* confirmed Marshall McLuhan's hypothesis that the medium is the message.<sup>219</sup> Digital technology is going to define the future of our society and the future of copyright law.<sup>220</sup> As technology burgeons, it will become more common to see entrepreneurs exploiting new technologies, and authors getting angry because these entrepreneurs are not sharing the profits from the use of the author's works.<sup>221</sup> Now that the Supreme Court has ruled that absent an express transfer, authors retain the electronic rights to their works, both authors and publishers must decide how they will interact, and how they will transfer new electronic rights.<sup>222</sup> Although each side will be acting in their own self interest, the system they adopt will inevitably be calculated to achieve

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limited rights in those contributions; and that consequences of removing works or requiring payment of royalties will not be devastating); Brief of Amici Curiae Authors Guild, Inc. et al. at 2001 WL 177047, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing Second Circuit properly weighed the interests of authors, publishers, researchers and electronic databases in finding publishers could not place articles in electronic databases without authorization); Brief of Amici Curiae Ellen Schrecker et al. at 2001 WL 177048, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing historians do not need commercial electronic databases to research, and copyrights of freelance writers should not be ignored simply to solve the unrelated problem of neglect of the nation's archives); Brief of Amicus Curiae International Federation of Journalists at 2001 WL 173557, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201) (arguing foreign courts have consistently recognized an author has a continuing copyright in the electronic publication of her work even though she has agreed to include her work in a printed collective work, the U.S. Copyright laws should be construed in conformity with similarly minded laws of other nations unless Congress has dictated otherwise, and the European experience teaches that ruling in favor of the authors' electronic rights does not result in the withdrawal of literary works from the Internet).

219. *Tasini*, 533 U.S. 483; see MCLUHAN, *supra* note 3; Dixon, *supra* note 6, at 155 n.113 ("the impact of the explosive growth of Cyberspace is difficult to exaggerate"). "There are people who believe that the computer revolution of this decade represents a fundamental change in society, one that will rank alongside the great social movements in history." Dixon, *supra* note 6, at 155 n.113, citing Paul Keegan, *The Digerati!*, N.Y. TIMES MAG., May 21, 1995, at 38.

220. See Fred H. Cate, *The Technological Transformation of Copyright Law*, 81 IOWA L. REV. 1395 (1996) (arguing that digital technologies will expand and redefine the scope of copyright law); Elina Mangassarian, *Technological Trends and the Changing Face of International Intellectual Property Law*, INT'L LEGAL PERSP. (2001); Jacqueline Lipton, *Copyright in the Digital Age: A Comparative Survey*, 27 RUTGERS COMPUTER TECH L.J. 333 (2001); Liz Robinson, *Music on the Internet: An International Copyright Dilemma*, 23 U. HAW. L. REV. 183 (2000); Michael J. O'Sullivan, *International Copyright: Protection for Copyright Holders in the Internet Age*, 13 N.Y. INT'L L. REV. 1 (2000); Charles S. Sims, *Understanding Tasini: The Litigation and its Impact on New Media Licensing*, 601 PLI / PAT 401 (2000) (arguing the basic assumptions of publishers and freelancers have changed after *Tasini*, and the industry has to adapt to the evolving "online society" by recognizing and compensating for newly arising issues).

221. Saez, *supra* note 186, at 366.

222. *Tasini*, 533 U.S. 483; see Santelli, *supra* note 21, at 278; Haemmerli, *supra* note 93, at 148; Atteritano, *supra* note 5, at 405; Sims, *supra* note 53, at 410; Forhan, *supra* note 144, at 883; Hur, *supra* note 35, at 90 n.258; Dixon, *supra* note 6, at 153 n.104.

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the ultimate goal of copyright: to promote the public welfare through both incentives to create new works, and public access to these new works.<sup>223</sup>

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223. See Atteritano, *supra* note 5, at 409. “No solution will satisfy everyone, but if we use the copyright institutions which already exist to assist in the transition which the publishing industry must make, and if authors are reasonable in their financial demands, all three parties to copyright (authors, publishers and users) will enjoy a second helping of the growing financial pie created by electronic publishing.” *Id.*